

1 IN THE UNITED STATES DISTRICT COURT
2 FOR THE DISTRICT OF NEW JERSEY
3 CIVIL NO. 12-04047
4 NITE GLOW INDUSTRIES INC. et al :
5 Plaintiffs, :
6 -vs- :
7 :
8 CENTRAL GARDEN & PET COMPANY et al :
9 :
10 : MARKMAN HEARING
11 Defendants. :
12 - - - - - :
13 Newark, New Jersey
14 February 8, 2016 10:30 a.m. & 2 p.m.
15 B E F O R E:

16 THE HONORABLE KATHARINE S. HAYDEN, U.S.D.J.

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36 Pursuant to Section 753 Title 28 United States Code,
37 the following transcript is certified to be an accurate
38 record as taken stenographically in the above-entitled
39 proceedings.

40 s\ RALPH F. FLORIO
41 Official Court Reporter
42

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7

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11 MARRI MARKELL

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13 NORMAN NORTON

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1 THE COURT: Good morning. You may all be seated.

2 Thank you. I am putting names with faces. Mr. Norman, will

3 you be presenting argument?

4 MR. NORMAN: I will, your Honor.

5 THE COURT: Ms. Colvin?

6 MS. COLVIN: Yes.

7 THE COURT: Mr. Garlock?

8 MR. GARLOCK: Yes, your Honor.

9 THE COURT: And Mr. Jenkins.

10 MR. JINKINS: Good morning.

11 THE COURT: Good morning. For the defendant, Mr.

12 Burnside.

13 MR. BURNSIDE: Good morning, your Honor.

14 THE COURT: Will you be arguing?

15 MR. BURNSIDE: I will be in part.

16 THE COURT: You are the other part, Mr. Slocum?

17 MR. SLOCUM: Yes, your Honor.

18 THE COURT: And who else is in the gallery?

19 MR. COONS: James Coons, local counsel for the

20 plaintiffs.

21 THE COURT: Okay.

22 MR. GARLOCK: Your Honor, this is the plaintiff

23 inventor, Marni Markell. Norm Norton is with her as a

24 guest.

25 Ernest D. Buff, who is representing the plaintiff

1 also.

2 THE COURT: Okay. Thank you.

3 I received, I guess, the Power Point from
4 plaintiffs. I think it's probably best, since we are talking
5 about construing the terms, if we begin with your
6 presentation then, Mr. Norman.

7 MR. BURNSIDE: Before we do that, if I could be
8 heard on this.

9 THE COURT: Sure.

10 MR. BURNSIDE: Your Honor, if you recall, the
11 plaintiffs submitted a letter roughly a week ago advising
12 that they were going to do a Power Point presentation, asking
13 for availability of technological equipment.

14 THE COURT: Do we have a copy of the letter? Give
15 me a chance, Mr. Burnside. I'm going to pull up on my screen
16 and get myself organized here, that way I will jump on to the
17 docket. So you may be seated while I do that.

18 MR. BURNSIDE: Thank you, your Honor.

19 THE COURT: Okay.

20 MR. BURNSIDE: Your Honor, I think it was an
21 email. I don't think it was filed, your Honor, if it's any
22 help.

23 THE COURT: Okay.

24 Back on the record. I have a letter of February 1,
25 Mr. Burnside, kind of noticing that Ms. Colvin would be

1 bringing a laptop and an elmo LCD projector. And a
2 projection screen requested.

3 THE COURT: Is that the email we are speaking of?

4 MR. BURNSIDE: Yes, your Honor, it is.

5 THE COURT: Come up to the podium then.

6 MR. BURNSIDE: So, your Honor, clearly a week or so
7 ago, the defendant was -- I'm sorry -- the plaintiffs were
8 prepared to present this. And rather than give us a copy at
9 that time, or even a few days ago, we literally received this
10 five or ten minutes before we walked in. I haven't had a
11 chance to look at it. I did peruse the first several pages.
12 I could tell you there is new material and citation of case
13 law we have not seen before. As best as I can tell from my
14 quick review. So in effect it actually constitutes or is
15 akin to a reply Markman brief, which I don't think is fair.
16 It's also-- also not fair to me to not get this ahead of
17 time.

18 Putting that aside for a moment, There's also some
19 what I'll call drawings. Maybe they are artist renders. I
20 am not sure what they are, which we haven't seen before,
21 which I am not sure are accurate. So I'm going to object to
22 any use of any portion of this Power Point that is not simply
23 a copy of what's in the Markman papers that have already been
24 submitted.

25 I don't object if they want to put up on the screen

1 an excerpt from their brief or an exhibit that they already
2 provided to both the court and us. But to the extent that
3 they want to get into case law that we have not had a chance
4 to review and critique, or if they want to show your Honor
5 artist renderings or schematics or diagrams that do not
6 appear in any Markman papers, I would object to all of that
7 because essentially it is a reply to the Markman brief.

8 And certainly if they are going to do that, they
9 should have asked for leave and give us a chance to weigh in
10 and given us a chance to respond as well, which of course
11 they haven't.

12 For those reasons I would object. And if your
13 Honor wants us to take a few minutes to go through every page
14 so I can tell you which ones we object to, I am certainly
15 happy to do that. I could tell you at the outset that what
16 I've been referring to appears on page 4 and page 5.

17 And it looks also to be that there's another patent
18 they are now referring to on page 19. I am sure there's
19 more. But that's what caught my eye in the few minutes I had
20 to review it.

21 THE COURT: Page 4 caught my eye too.

22 The procedure will follow this. It's not the first
23 time that I have been presented with the wherewithal for
24 Markman presentation on the day of. And while I agree, it's
25 easier on me and on everybody if there was some effort to

1 pass it by your eyes earlier, I am not going to exclude it or
2 go through objections before I entertain it. I'll let the
3 plaintiff make the presentation.

4 But to the extent that you have objections and feel
5 that -- let's do two things. Let the record reflect your
6 objection at the time that page 4 -- we know you are
7 objecting to. When we get to page 4, I'll hear why and we'll
8 go from there so that you have a record of why you are
9 objecting.

10 And to the extent that I feel that there needs to
11 be some kind of a back and forth, I'll permit you to do it.
12 Or you could incorporate what you noted at the time that you
13 make your presentation. Makes sense?

14 MR. BURNSIDE: Thank you, your Honor. And your
15 Honor, perhaps if there's anything material, if we might have
16 an opportunity to submit a short written response within a
17 few days, a week or so.

18 THE COURT: We will see what's left over.

19 MR. BURNSIDE: All right.

20 THE COURT: We will embark on this with our usual
21 resolve. And after a couple of hours, tattered and torn,
22 we'll see where we are at. Okay?

23 MR. BURNSIDE: Thank you, your Honor.

24 THE COURT: Okay. Good. We are going to have to
25 make a little bit of a break so I could get hook up with

1 Ralph on the Live Note. Mr. Norman, come up.

2 MR. NORMAN: Good morning, your Honor.

3 THE COURT: Good morning.

4 MR. NORMAN: This morning we will be discussing
5 disputed terms in the claims of the patent in suit. The
6 patent in suit is U.S. Patent 8,057,445. Page 1 of that is
7 on the screen.

8 Now the patent is directed to an applicator for
9 direct delivery of a solution such as flea, tick insect
10 repellant to an animal's skin and to also avoid having that
11 solution contact the user's skin, because this is not the
12 type of medicine that you want on the human skin.

13 Figure 3 is actually a figure from 1a from the '445
14 Patent. We have highlighted this to make the discussion
15 easier.

16 Generally speaking, I have put this on as an
17 embodiment, because this is an embodiment of the '445 Patent
18 to give the court a little bit of an understanding as to how
19 the invention works, what the invention is.

20 Generally speaking, the invention of '445 Patent is
21 an applicator, comprising an applicator base. That's going
22 to be the portion shown in pink. The applicator base has a
23 chamber. The chamber is shown in blue. And the purpose of
24 the chamber is the chamber receives a solution cartridge.
25 And the solution cartridge is shown in yellow.

1 The applicator also includes at least one prong
2 member. This particular embodiment has 4 prong members.
3 Those are the green members on the left end of the device.

4 Now in use, the cartridge is placed in the chamber
5 where the user squeezes the applicator, solution is squeezed
6 from the cartridge, it flows through at least one prong
7 member on to the skin of the animal. The prong member can be
8 placed against the skin of the animal so the solution is
9 applied directly to the skin rather than on the fur and so
10 that it doesn't get on the person.

11 Your Honor, in connection with construing the
12 disputed claim terms, knowledge of the accused product
13 provides meaningful context.

14 As the Fed Circuit said in the Wilson Sporting
15 Goods case: In reviewing claim construction in the context
16 of infringement, the legal function of giving meaning to
17 claim terms always takes place in the context of a specific
18 accused infringing device or process. While a trial court
19 should not prejudge, the ultimate infringement analysis
20 construes claims with an aim to include or exclude an accused
21 product or process, knowledge of that product or process
22 provides meaningful context for the first step of the
23 infringement analysis claim construction.

24 So your Honor, what we would like to do is show you
25 one of the accused products. There are several different

1 ones. If I -- I might hand you one. I've got an actual
2 sample. May I approach to hand --

3 THE COURT: Is there an objection?

4 MR. BURNSIDE: Your Honor, this is the screen that
5 was just on, that counsel read from, is one of the ones I
6 object to. I think you wanted me to pipe up every time I
7 have an objection on the record. And the point of the that
8 is--

9 THE COURT: Yes.

10 MR. BURNSIDE: -- this I do not believe, as best I
11 can tell, I am sure if I am wrong, one counsel would jump
12 up. This was one of the citations that was not in the
13 Markman briefing. If it's so elementary, it begs the
14 question why. Which makes me a little suspicious. I would
15 like the opportunity to go into this and respond. Obviously
16 not today, whenever your Honor permits me, a week or so if
17 possible.

18 THE COURT: Are you objecting to the exemplar that
19 Mr. Norman has in his hands? Have you shown your adversary?

20 MR. BURNSIDE: I'm not objecting to the exemplar.
21 Again, it would be nice if I was told it was going to be used
22 today. But putting that aside, I want to make sure I am
23 registering my objecting to the use of page 4, which we just
24 passed, apparently.

25 And now I have an objection to page 5 as well

1 because that was not in any of the exhibits. And to the
2 extent that the pictorial part or artist's rendering part
3 hasn't been produced at all in discovery, I doubt various
4 labels have been produced on that very one. And again I
5 object to that.

6 I don't know how accurate this -- I would expect to
7 have issues with some of descriptions or titles that appear
8 on this document. Had I had the time to look into to it,
9 then I'd be prepared to do that.

10 MR. NORMAN: These are photographs of the used
11 products that we have here.

12 THE COURT: Taken apart in other words?

13 MR. NORMAN: No. I could explain it.

14 MR. JINKINS: Your Honor, be careful with that.
15 There is solution in there. If you do break it--

16 THE COURT: I don't intend to do that. Off the
17 record.

18 (PAUSE).

19 THE COURT: Back on the record.

20 THE COURT: Mr. Norman, you may continue. I have
21 the exemplar here.

22 MR. NORMAN: Now the accused product is an
23 applicator for directing -- for directly delivering a
24 solution such as flea tick or insect repellant to an animal's
25 skin.

1 Now the applicator comprises of two primary
2 components. It's going to have the applicator base. That's
3 the purple and dark gray item and it has the solution
4 cartridge. That's the pink.

5 Now in the photo, you see we have two pictures of
6 the cartridge. One is just the bottom view and one of the
7 top view. The accused product doesn't have three items. It
8 has only the two items.

9 The applicator base has a chamber in it for
10 receiving the solution cartridge. So that would go in like
11 so (indicating). But I don't want to close the lid. Because
12 if I close the lid, the lid will break off the tip and expose
13 the end of the prong. So the user sticks it in and closes
14 the lid, that will break off this prong -- that's in there.
15 And then the user squeezes the solution cartridge. I'm
16 sorry. The user squeezes the applicator base, that will
17 squeeze the cartridge and cause solution to squirt out the
18 prong member.

19 In this case, Nite Glow accuses defendants of
20 infringing Claims 1 and 16. Claim 1 is an independent
21 claim--

22 MR. BURNSIDE: Excuse me, your Honor. Did you want
23 me to address 5 before we move on to 6?

24 THE COURT: Are you talking about the page 5?

25 MR. BURNSIDE: Yes, page 5.

1 THE COURT: So you have objections to the rendering
2 on page 5?

3 MR. BURNSIDE: Well, your Honor I have three
4 separate objections.

5 THE COURT: Okay.

6 MR. BURNSIDE: One is again, we were not provided
7 in advance. I just want to make that clear.

8 Two, this is not an evidentiary hearing with
9 respect to infringement. So why we are even discussing the
10 accused products is improper? That's number two.

11 And number 3, I completely disagree with some of
12 the characterizations and some of the titles that appear on
13 here, because they are completely inaccurate. And again,
14 this is an attempt to affect the Markman hearing with
15 infringement issues, which I think is improper.

16 I can respond to some of the titles that I think
17 are improper or inaccurate now, later, at your, whatever you
18 feel is appropriate.

19 THE COURT: Yes.

20 MR. NORMAN: Your Honor--

21 THE COURT: Mr. Norman, let me just ask you. How is
22 this any different than you would be presenting an
23 infringement case?

24 MR. NORMAN: Your Honor, I am not talking any more
25 about the accused product. I just wanted to give the court

1 the context. And that is what slide 4 says.

2 Slide 4 said that this is a Federal Circuit saying
3 that in the context of claim construction, it is good for the
4 court to be knowledgeable of the accused product.

5 Now, also says that a trial court should certainly
6 not prejudice the ultimate infringement analysis by construing
7 claims with an aim to include or exclude an accused product
8 or process. Nevertheless, knowledge of that product or
9 process provides meaningful context. I just wanted to
10 provide that context. But I have already done so. So I am
11 not going to -- I don't need to further discuss, nor what was
12 I further planning to discuss the accused product.

13 MR. BURNSIDE: Your Honor, my problem, my concern
14 is had I known in advance that we were all going to give our
15 sort of views on the accused product and our take on it, I
16 would have prepared my own an analysis that would have been
17 in conflict with some of what you just heard already.

18 I do strenuously disagree with not only the
19 description but also the labels that have appeared.

20 THE COURT: Let me -- this is going to be in the
21 nature of pure torture, not of animals but of humans, if I
22 don't put some context in this.

23 I want to see what the context for that context
24 quote is, whether or not this is an-oh-by-the-way, whether or
25 not, this is whether or not some obtuse argument came out.

1 Because if it were this fundamental, this is how you would
2 have had your whole argument. I would have had little
3 exemplar as to infringement -- but not that -- we are doing
4 claim construction and I want to take time out and look at
5 the particular cases you are relying on and let's see how
6 important it is.

7 If I rule that we have had enough, then we're going
8 to go into the claim construction and I'm going to want to
9 know from you, Mr. Norman, what pages or the actual claim
10 terms anticipated argument you're going to be using in your
11 spiral binder. And I'm going to ask you to give those page
12 numbers to your adversary and then we could see whether or
13 not we have one continuing objection to untimeliness in Mr.
14 Burnside's estimation of having shared this. Or if he has a
15 specific extra one. So ten minutes. I will review the
16 case. Thank you.

17 MR. BURNSIDE: Thank you.

18 MR. NORMAN: Thank you.

19 THE COURT: I do expect you to confer with each
20 other about this document. Right? Like I just said.

21 MR. NORMAN: Yes.

22 MR. BURNSIDE: Yes.

23 THE COURT: Counsel, see me in the robing room
24 please.

25 (Off the record).

1 THE COURT: Back on the record.

2 I have had an opportunity to review the case that
3 was cited on page 4 at the plaintiffs' presentation, Wilson
4 Sporting and Goods Company v. Hillerich & Bradsby Company, a
5 decision by the Federal Circuit in 2006.

6 And as I thought, the context of -- the context
7 remark that is cited on page 4 lends a little bit of, or is
8 important in how much weight to give that particular quote.

9 The quote is: While a trial court should certainly
10 not prejudge the ultimate infringement analysis by construing
11 claims with an aim to include or exclude an accused product
12 or process, knowledge of that product or process provides
13 meaningful context for the first step of the infringement
14 analysis. And cites to a case.

15 Then the Federal Circuit in the next paragraph
16 addresses the problem before it in the Wilson Sporting Goods
17 case. Quote: In this case, meaning Wilson Sporting Goods,
18 despite entry of a final judgment, neither of the trial court
19 nor the parties supplied this court with any information
20 about the accused products. Thus, this record affords this
21 court, meaning the Federal Court, no opportunity to compare
22 the accused products to the asserted claims. Accordingly,
23 this court cannot assess the accuracy of any infringement or
24 valid determination. Furthermore, this sparse record lacks
25 the complete context for accurate claim constructions.

1 What happened there, there was claim construction
2 and then almost on the heels of that, a final judgment
3 entered by the district court that there was no
4 infringement. And so the Federal Circuit is complaining
5 about this sparseness of the record.

6 And in that context says, hey, some idea of what
7 the accused product is-- is a necessary part of it, because
8 every claim construction happens not because people feel like
9 construing claims, but because there is an overall litigation
10 on infringement.

11 Then finally, and this is what's important here to
12 me. While asking for the additional context of what the
13 accused product was, and saying because we don't have it, we,
14 the Federal Circuit, cannot fully and confidently review the
15 infringement judgment, not the Markman construction, but the
16 infringement judgment, including the claim construction
17 component. So that's very secondary to the observation.

18 The court comes back to this important principle,
19 which we are all familiar with. Quote: This Court of course
20 repeats its rule that claims may not be construed with
21 reference to the accused device.

22 So I think that that was your point, Mr. Burnside.
23 That is the fundamental law. And to the extent that page 4
24 gives us an interesting bit of broadening, it doesn't apply
25 to what we're doing here. We are not moving to

1 infringement. It's a fair objection to say it sounds like we
2 are getting there and it's a fair answer.

3 Mr. Norman says, that's it, where I'm going, I have
4 done it, I have kind of given you as context. Let's keep it
5 as context and let's leap into the claims that we are dealing
6 with, otherwise we will be here until the animals come home.
7 Since we are not dealing with a cows.

8 Now, I think on page 8, we have the claim terms to
9 be construed?

10 MR. NORMAN: Yes, your Honor.

11 THE COURT: Okay.

12 MR. NORMAN: Your Honor--

13 MR. BURNSIDE: Your Honor, I note, however, page 8
14 does not include all of the page terms.

15 THE COURT: When we were preparing for this, it was
16 apparently, there is some question about whether or not the
17 defense has abandoned some of the claimed terms or what?

18 MR. NORMAN: Your Honor, we are asserting claims,
19 only claims 1 and 16. So the only disputed claim terms that
20 are in claims 1 and 16 are these listed.

21 THE COURT: All right. And Mr. Burnside, you are
22 saying there's more that we will be finding out about?

23 MR. BURNSIDE: Your Honor, the parties had
24 originally identified three additional -- at least three. I
25 think there's also a commingling of a couple of claims. I'll

1 put that aside for the moment.

2 But there are three that we had originally agreed
3 to that needed to be construed. And they are flat, which I
4 concede does appear in Claim 18. Angle tip which appears in
5 Claim 6. Just like -- well, angle tip and elongated
6 cylindrical shape, which appears in Claim 7.

7 MR. NORMAN: And we are not asserting any of those
8 three claims. So it's unnecessary for the court to construe
9 those terms.

10 MR. BURNSIDE: However, your Honor, some of the
11 definitions provided and some of the rationale provided for
12 some of those now dropped claims terms are relevant. For
13 example, flap.

14 THE COURT: Let me ask you something, Mr.
15 Burnside. Did you raise the apparent omission of these three
16 terms in any papers before me, or what?

17 MR. BURNSIDE: Well, they weren't omitted in the
18 opening Markman briefs from either party.

19 MR. NORMAN: Your Honor--

20 THE COURT: Wait.

21 MR. BURNSIDE: Your Honor, they choose not to
22 address them in a subsequent filing. And in fact, we make
23 known in footnote 2 of our response brief this very issue.

24 So we have not consented to the sudden dropping
25 without any explanation of these three claims terms. And I

1 will again reiterate that one of those claim terms flap is
2 very relevant because of how the plaintiff defined it with
3 respect to the other claim terms. So I don't want it to be
4 construed that we how somehow agreed with omission.

5 I might agree as we get through these claim terms
6 that perhaps we don't have to construe all three of these now
7 omitted on their side claim terms. But I don't want it to be
8 construed that we could just ignore them completely, because
9 you're going see that flap is a very relevant claim term when
10 we get to some other claim terms that are listed on the
11 screen.

12 THE COURT: I think it may be right. Let's wait
13 and see what happens then.

14 MR. BURNSIDE: Thank you, your Honor.

15 THE COURT: Go ahead.

16 MR. NORMAN: One point from a procedural
17 standpoint. The parties had discussed this earlier, that we
18 will be -- if the court is okay with this procedure, we will
19 do this on a term-by-term basis. So after I explain the case
20 law that I am going to be addressing and stuff, and we hit
21 the first claim term, then counsel for the defendant will
22 give the arguments on that and then we'll move on
23 term-by-term basis.

24 THE COURT: That's fine. Sounds good to me.

25 MR. NORMAN: So, your Honor, here are Claims 1 and

1 16. We have the disputed -- there are nine disputed claim
2 terms that in Claim 1. There is one disputed claim term in
3 Claim 16. And we have highlighted the disputed claim terms.

4 Claim 16 is a dependent claim, depending from Claim
5 1, and as such Claim 16 contains all of the limitations of
6 Claim 1, plus the additional limitation recited in Claim 16.

7 When we do begin to address the terms, we will
8 address the terms in the order in which they appear in the
9 claims.

10 The principles of claim construction are set forth
11 in the Phillips decision. That's going to be Phillips v. AWH
12 Corp. 415 F.3d 1303. That's Fed Circuit 2005, En Banc
13 decision. In Phillips, an En Banc Federal Circuit stated,
14 words of a claim are generally given, their ordinary and
15 customary meaning.

16 The ordinary and customary meaning of a claim term
17 is the meaning that the term would have to a person of
18 ordinary skill in the art in question at the time of the
19 invention, i.e., as of the effective filing date of the
20 patent application.

21 The court explained that a person of ordinary skill
22 in the art is going to have knowledge of any special meaning
23 and usage in the field.

24 The meaning of the disputed claim term is to be
25 ascertained from the intrinsic record. The intrinsic record

1 is the patent itself and the prosecution history.

2 The Federal Circuit said that claims must be read
3 in view of the specification of which they are apart. And
4 specification includes the written descriptions, plus the
5 claims.

6 Now, if the disputed claim term is not a term of
7 art, then the disputed term is going to have the same meaning
8 to a lay person as it does to a person of ordinary skill in
9 the art.

10 A Federal Circuit said that in those cases, in
11 those cases in which the term in dispute is not a term of
12 art, then general purpose dictionaries may be helpful.

13 In many cases -- but then goes on to say, in many
14 cases that give rise to litigation, however determining the
15 ordinary and customary meaning of the claim requires
16 examination of terms that have a particular meaning in a
17 field of art.

18 In the present case, none of the disputed terms are
19 terms of art. So general purpose dictionary may be helpful
20 to the court.

21 In Phillips, the Federal Circuit recognized two
22 circumstances in which a term may have a definition different
23 from the plain and ordinary meaning.

24 Lexicography and disavowal. A lexicography occurs
25 where the inventor explicitly sets forth a definition in the

1 specifications. And disavowal occurs when the inventor
2 specifically disavows a meaning.

3 Under Federal Circuit precedent, claim terms are to
4 be given their plain and ordinary meaning unless lexicography
5 and disavowal apply.

6 Now after the disputed claim terms in this case,
7 defendants argue for definitions that are not ordinary.

8 Given the facts of the present case, adopting a non
9 ordinary definition would violate the principles set forth in
10 Federal Circuit precedent.

11 I want to direct the court's attention to GE
12 Lighting Solutions, LLC v. A-G-I-L-I-G-H-T, 750 F.3d 1304 Fed
13 Circuit 2014. GE Lighting cases are certainly cited in our
14 briefs.

15 In GE Lighting, the Federal Circuit reversed the
16 claim construction proposed by the defendant and adopted by
17 the district court. The claim construction approach that was
18 rejected by the Federal Circuit in GE Lighting is the same
19 approach proposed by defendants in our case.

20 Now the disputed claim term in GE Lighting was IDC
21 connector. An IDC connector is an electrical connector which
22 pushes insulation away from the end of the wire when the wire
23 is inserted in the connector.

24 The district court recognized that an IDC connector
25 is commonly used in electrical engineering to connote a range

1 of the devises, but found that the patents in suit were
2 limited to a more specialized IDC connector.

3 The district court relied on the embodiment
4 disclosed in the specification to conclude that the term IDC
5 connector was limited to the particular type of IDC connector
6 that was shown in the patent specification.

7 The Federal Circuit reversed. A ruling that the
8 term IDC connector must be given its plain meaning of, "a
9 connector that displaces insulation surrounding an insulated
10 conductor to make electrical contact with the conductor."

11 The court found that nothing in the specification
12 or prosecution history required departure from the plain and
13 ordinary meaning.

14 Now, the court confirmed that claim terms must be
15 given their plain and ordinary meanings unless the
16 specification and prosecution history compel a departure from
17 the plain meanings.

18 The court said the specification and prosecution
19 history only compel departure from the plain meaning in two
20 instances, lexicography and disavowal. And then it goes on
21 to explain these a little bit more.

22 It says, the standards for finding lexicography and
23 disavowal are exacting.

24 It further said to act as its own lexicographer, a
25 patentee must clearly set forth the definition of the

1 disputed term and clearly express an intent to define the
2 term.

3 Similarly disavowal requires that the specification
4 or prosecution history make clear that the invention does not
5 include a particular future.

6 In GE Lighting, the Federal Circuit determined that
7 no lexicography or disavowal apply, and that the claim term
8 must be given its plain and ordinary meaning.

9 It said it was error to import structural
10 limitations of preferred embodiments and the structural
11 limitations of dependent claims into the term IDC connector.
12 So the claim term is to be given its plain and ordinary
13 meaning except where a patentee clearly sets forth and
14 intends to set forth a different definition; or where a
15 patentee, or where a particular meaning has been clearly
16 disavowed in the patents or prosecution history by the
17 patentee.

18 Now to give the court an example of lexicography in
19 a patent, we conducted a quick search and we located a patent
20 that just issued this past Tuesday. This patent is not
21 relevant to our case at all. It is to merely to show the
22 court an example of lexicography.

23 This is a slide though that the defendants have
24 objected to. It is for the limited purpose of just showing
25 an example of a case where the term was specifically defined

1 in the specification.

2 THE COURT: Mr. Burnside, you're noting your
3 objection?

4 MR. BURNSIDE: Yes, your Honor. If I could take a
5 moment to elaborate. Much like I think your Honor found with
6 respect to the Wilson case, that snippet from that case was
7 not entirely an accurate depiction of what's relevant today.
8 I suspect the same here. I don't think we have seen this
9 before and I would like an opportunity to address it.
10 Obviously, I wouldn't do that today.

11 But what I would propose, your Honor, is that we'll
12 find this patent or maybe the plaintiffs can produce it and
13 we'll look at it. If we think we need to address, we'll ask
14 your Honor to opportunity to submit a short letter brief. If
15 we decide we don't need to address it, we'll let your Honor
16 know as well if that's permissible.

17 THE COURT: Let's listen carefully. This is
18 another exemplar, an example.

19 MR. NORMAN: Yes.

20 THE COURT: Okay.

21 MR. NORMAN: So in the patent, in column 7,
22 beginning on line 1, you see that there's a section that says
23 definition. This is a section of the patent's specification
24 and it actually says definitions, and then it specifically
25 explicitly sets forth definitions of terms that are used in

1 the patent. I have highlighted a lot of these terms in
2 yellow. I have specifically highlighted some terms in green
3 just to show how a claim term, how a term can be defined in a
4 way that is going to be a special meaning. It's not going to
5 be its ordinary meaning, because the patentee can act as his
6 own lexicographer to define a claim.

7 It says similarly when we refer to a vehicle, we
8 meaning and then list a lot of things, including pedestrians,
9 pets, livestock, wild animals.

10 I show this only to show that if a patentee wants
11 to define a term and given a meaning different from its
12 ordinary meaning, it can do so by explicitly setting it forth
13 in the patent specifications. Something that did not occur
14 in connection with the patent in suit.

15 And I think most people would agree that the
16 ordinary meaning of vehicle, for example, would not include
17 pets, livestock, wild animals. And then it lists other terms
18 as well.

19 THE COURT: Okay.

20 MR. NORMAN: So in connection with the '445 Patent,
21 no term was explicitly defined, so no lexicography occurred.
22 No term, the meaning of no term what was disavowed by the
23 patentee, experts -- both sides had experts that had
24 submitted declarations and where deposed in this case. The
25 experts did not identify any of the disputed terms as terms

1 of art.

2 Applying the Federal Circuit principle set forth in
3 GE Lighting, because there's no lexicography or disavowal in
4 present case, the definitions of the disputed terms cannot
5 depart from their ordinary meanings.

6 And because none of the disputed terms are terms of
7 art, they have the same meaning to a lay person as they do to
8 a person of ordinary skill in the art. All right.

9 Finally we are getting to the first term in the
10 first disputed term in the claims.

11 First term is direct delivery applicator. The term
12 direct delivery applicator occurs only in the preamble of the
13 claim.

14 Now the preamble of the claim, your Honor, is going
15 to be all the words occurring before confining, at least in
16 this particular example.

17 The body of the claim is going to be the sub
18 paragraphs A, B, C, D, E, and then the wherein clause in
19 connection with Claim 1.

20 Now the Federal Circuit has said that terms used
21 only in the preamble are not given patentable weight and need
22 not be construed.

23 Then we've got some citations to that. That is
24 going to be in Intell-A-Check Corp. v. Autoscribe Corp. And
25 this case is cited in our briefs.

1 The term direct delivery applicator does not occur
2 at all in the body of the claims. The term direct delivery
3 applicator is merely the name of the apparatus given in the
4 claims. Because the term is used only in the preamble, it
5 has no patentable weight and the scope of the claim would be
6 no different if the term direct delivery applicator were
7 replaced with the word apparatus, device or anything.

8 Because the patent is set forth in the body of the claims.

9 Now defendants argue -- I guess my point is, the
10 court need not construe this claim term at all.

11 Defendants argue that the term direct delivery
12 applicator should be given an uncommon non ordinary
13 definition.

14 Defendants define it as a device comprised of a
15 chamber made of rubber, an applicator base, an applicator
16 head, a internal channel, at least three prongs wherein such
17 prongs must be in contact with the animal skin as solution is
18 pushed from a removable cartridge through the internal
19 channel of the prongs by asserting pressure on the rubber and
20 secreted through the prongs directly on to said skin.

21 So the words that we have are direct delivery
22 applicator. One would think ordinary meaning of these
23 English words is going to be something in the realm of an
24 applicator that directly delivers something. Just look at
25 that those terms. Those are going to be ordinary meaning of

1 those terms.

2 If you look at defendants' definition of them,
3 though they have all sorts of limitations that you are never
4 going to see any dictionary definition for these terms. And
5 I recognize the phrase of course direct delivery applicator
6 as a phrase would not occur in any dictionary. But certainly
7 all three of these terms are.

8 And the term direct delivery applicator was
9 certainly not set forth as a definition anywhere in the
10 patent's specification.

11 We also, as we look at their claim, I mean as we
12 look at their proposed definition, in addition to all of
13 these limitations they have said must be in this direct
14 delivery applicator, of course they include a lot of
15 limitations that aren't even set forth in the claim itself.

16 For example, it says it has to have at least three
17 prongs. And then it says, it adds a method of use to this
18 apparatus claim, which is certainly improper, it says wherein
19 such prongs must be in contact with the animal skin as
20 solution is push from removal cartridge through the internal
21 channels of the prongs by asserting pressure on the rubber.

22 This phrase, wherein said prongs must be in contact
23 with the animal's skin as this is happening, I mean it's
24 defining a device only at the time that it is being in use
25 used. Of course any type of an applicator that is going to

1 be able to dispense some type of a fluid, it doesn't have to
2 be pushed against anything in particular in order to dispense
3 fluid.

4 Now the purpose of the device might certainly be to
5 dispense it on to an animal's skin. It certainly can't be
6 that if a -- that if it dispenses it just on the person, that
7 it somehow no longer a direct delivery applicator. That
8 would really make no sense.

9 Now next slide. So as I mentioned earlier, it's
10 improper to give a term a definition other than an ordinary
11 meaning unless there's lexicography or disavowal, for
12 lexicography to occur where clear expression of intent to
13 define the term must be present, no clear expression of
14 intent to define the term direct delivery applicator is
15 anywhere in the patent. The ordinary meaning of direct
16 delivery applicator is an applicator for delivering something
17 directly. But, as we said in our briefs, the court does not
18 need to construe the term direct delivery applicator because
19 it has no patentable weight. Thank you.

20 THE COURT: Mr. Burnside, do want to address that
21 argument? Thank you.

22 MR. BURNSIDE: Thank you, your Honor. Your Honor,
23 let me start by discussing some of the elemental case law.
24 And I would note in the discussion we just heard, a couple of
25 things, a couple of very basic things were left out. And I

1 would like to start by focusing on that.

2 As we have briefed, one of the fundamental concepts
3 of claim construction is that the construction should stay
4 true to the claim language and most naturally align with the
5 inventor's description of the invention.

6 Further, the claim language is to be interpreted to
7 serve the inventor's purpose. Those are both cited in our
8 briefs, in our opening brief and our responsive brief. So
9 that leads me to what's the essential purpose of this
10 invention.

11 Now, the patent itself, the application, the
12 prosecution history is replete with descriptions of an
13 accurate and clean delivery on to an animal's skin. It's
14 supposed to be an improvement of the then existing conditions
15 where people were applying this medicant, this flea and tick
16 solution and getting on their hands and on the coat of the
17 dog and not getting on the skin the dog. So it's supposed to
18 be vastly improved direct and accurate and clean delivery.

19 In order to accomplish that, again this is replete
20 throughout the patent and the prosecution history, the
21 inventor's own documents, the hair has to be dispersed. It
22 has to be separate. In order to do that, a comb like
23 structure is being used. Several teeth and several prongs,
24 teeth and prongs are par equivalent according to the inventor
25 in deposition testimony.

1 So the applicator is supposed to have a number of
2 prongs or teeth at the very end to get into and separate the
3 hair so that direct delivery could be made with contact on
4 the skin of the dog. Between the applicator and the dog's
5 skin. And there are multiple references throughout the
6 patent with respect to contact with the skin.

7 I would just point out column 2 line 63, for
8 example, "substantially contacts the animal's skin."

9 I wouldn't go through all the numerous references.
10 There are at least a half dozen supporting references which
11 make clear that the prongs or the teeth have to make
12 substantial contact with the skin, because that's the
13 inventor's essential purpose of this invention.

14 So when we hear arguments that a preferred
15 embodiment should not be construed in defining a claim term,
16 or that we have to look at the inventor's understanding of
17 ordinary words and the ordinary definitions of applied to
18 those words, we have to be mindful that the Federal Circuit
19 made clear all these claim terms have to be construed to be
20 consistent with the essential purpose of the invention.

21 With that in mind, let me turn to the direct
22 delivery applicator.

23 Now, we've already heard that term used in just
24 general argument and discussion by the plaintiffs on a number
25 of occasions. It's used constantly in connection with issues

1 that are before the magistrate currently and in the past.
2 And it's going to be used extensively at the trial. Even
3 though it is not in an actual claim, we also can't ignore
4 it. Because the plaintiffs are going to argue that direct
5 delivery applicator is an all-encompassing thing.

6 In fact, if you look at figure 1a of the patent,
7 figure 1a of the patent just below the figure period 1a has a
8 10 with an arrow pointing to the overall diagram. And that
9 10 is defined as or characterized as the direct delivery
10 applicator.

11 So the direct delivery applicator includes all of
12 these different fundamental aspects that are, that appear in
13 figure 1a. Which is why we have defined the term as already
14 presented because it takes into account all of these
15 different features toward the essential functional element of
16 this invention, to deliver the medicant directly to the dog's
17 skin by parting the hair with multiple the prongs or multiple
18 teeth.

19 THE COURT: What do we do about the placement of
20 those three words in preamble as opposed to within the
21 claims?

22 MR. BURNSIDE: I understand it's in the preamble.
23 I concede that. I further concede it is not in any of the
24 claims. My point is it doesn't mean you ignore it because
25 it's going to be used and it's going to be a source of

1 disagreement if this court doesn't somehow doesn't define
2 that particular claim term -- term I should say.

3 Now I would add, the parties had long ago agreed,
4 when we did our submissions pursuant to local patent rules,
5 that this was a term that needed to be defined. And in fact,
6 the plaintiffs provided their own definition in their opening
7 Markman brief. And that definition is not a simple, oh,
8 it's an apparatus. It says words to the effect, a direct
9 delivery applicator includes -- and I'll have much to say
10 about the word includes later on. -- an applicator for
11 receiving a cartridge for delivery of solution to an animal's
12 skin.

13 Now, granted the defendants' definition is somewhat
14 longer than that. The point of the matter is that even they
15 felt this had to be defined. Suddenly they have changed
16 their mind. I am sure litigation strategy or something
17 perhaps developed in this case since they agreed it should be
18 defined. Initially they did agree. Because it's been used
19 so often in this case and will be used so often, my
20 suggestion or request to your Honor, we can't simply ignore
21 it because that will create problems at trial, summary
22 judgments motions, and so forth. Because it is used
23 consistently and it's used in a very broad sense. And that
24 is the problem I have. If they are going to use it in a
25 broad sense, then it needs to be defined so that you, the

1 jury, the magistrate, even myself and my worthy adversaries
2 are all on the same page as to what that term means.

3 THE COURT: All right. It's a practical argument
4 that you are making and I understand it. Okay. Let's move
5 on.

6 MR. BURNSIDE: Thank you, your Honor.

7 THE COURT: Okay.

8 MR. NORMAN: May I respond, your Honor?

9 THE COURT: No. Let's go on.

10 MR. NORMAN: Your Honor, the next term is
11 applicator base. One thing I would like to mention though,
12 if I may, and that is, the defendants in their brief made, in
13 their reply brief that is going to be document 116 on page
14 14, defendants said, and it was repeated just now by Mr.
15 Burnside, the Federal Circuit has observed that claim terms
16 should be interpreted so as to serve the inventor's
17 purposes. And he sites the Bausch & Lomb case. The Bausch &
18 Lomb case does not at all say that. Claim terms are not to
19 be construed, are not to be construed to serve the inventor's
20 purpose. And that is not what the Bausch & Lomb case said.
21 That would make it contrary to what the Federal Circuit has
22 said in the Phillips decision. Of course this was -- the
23 Bausch & Lomb case was a 1986 case.

24 Katie, will you pull that up.

25 The Bausch & Lomb case was a 1986 case. In that

1 case it didn't say you construe or interpret a claim term to
2 serve the inventor's purpose. Rather, the Federal Circuit
3 said, it was looking at a particular term, a relative term.
4 The relative term that was being addressed in that case was
5 smooth. The term smooth.

6 Now the Federal Circuit said, look, a term like
7 smooth, you have to construe in a particular context.
8 Because smooth could have different meanings. If you are
9 talking about the grass was cut smooth. Or smooth peanut
10 butter on bread. Or smooth surface of a contact lens. Or a
11 smooth surface on a semi conductor waiver, which is going to
12 have to be polished much more smoothly than a mirror.

13 Now the particular product at issue in the Bausch &
14 Lomb case was of course a contact lens. So it doesn't say --
15 here's where they get the quote from. But the quote isn't
16 saying you interpret a claim, that you must interpret a claim
17 to serve the inventor's purpose. It was just saying in this
18 particular case, looking at the word smooth, we hold that
19 smooth means smooth enough to serve the inventor's purpose,
20 i.e., something that was stated in the patents, i.e., not to
21 inflame or irritate the eye lid of the wearer will be
22 perceive by him at all when in place.

23 So this is not a principle, there's no principle of
24 patent law that is stated in Bausch & Lomb to the effect that
25 the court must, the terms must be construed to serve the

1 inventor's purpose. Rather claim terms are to be given their
2 plain and ordinary meaning. That was repeated in the
3 Phillips decision, the En Banc 2005 decision, and it's been
4 stated in scores, maybe hundreds of Federal Circuit cases
5 since. Plain and ordinary meaning except in two exceptions,
6 neither of which are an applicable here.

7 Now with respect to the claim terms also, your
8 Honor. We are going to have applicator base. We are going
9 to have different terms. And the terms that we are going to
10 be looking at, these are looking at the meaning of these
11 terms. This is not the same thing as saying that we are
12 going to have to ignore everything else in the claim.

13 In order for the plaintiff to establish
14 infringement in this case, we have the burden of proofing
15 that the accused product includes every requirement set forth
16 in Claim 1. Not merely the presence of the disputed terms.

17 The question is going to be, what do these disputed
18 terms add. So we look at the term applicator base though.

19 As for the term applicator base, we see that it
20 occurs two times. First as an applicator base, having a
21 chamber comprising a top surface with a first opening. And
22 then in sub paragraph D, in the context it says, said chamber
23 of said applicator base being composed of a flexible
24 deformable material said chamber of said applicator base.

25 Now defendants assert that applicator base be

1 defined as the bottom portion of the chamber made of flexible
2 deformable material.

3 Defendants' proposed definition, moving to the next
4 slide. Okay. So defendants' definition is inconsistent with
5 the claim language itself. The defendants asserted that the
6 applicator based is the bottom portion of the chamber, where
7 Claim 1 says the applicator base has a chamber. The chamber
8 is a region of the applicator base, not vice versa, as
9 proposed by defendants.

10 Defendants' definition right there conflicts with
11 the claim language itself which must therefore be incorrect.

12 Now defendants' definition also says that an
13 applicator base must be made of a flexible deformable
14 material.

15 Now the definition of applicator base though does
16 not require a particular material.

17 Now the claim has different requirements. But the
18 question is solely what is the meaning of applicator base.
19 If applicator based was -- if applicator by definition was
20 required to have certain characteristics, then it would be
21 unnecessary to include those characteristics in the claim
22 language itself.

23 In the Phillips case itself, the term at issue was
24 baffles. The Federal Circuit said, you can look at the claim
25 language itself to determine the meaning of a term, or at

1 least to help you a bit. In that case it said, look, if you
2 look at it in context, the claim requires steel baffles,
3 which means that -- the Fed Circuit said, which means that
4 because it had steel in the claim, that means baffles is not
5 inherently made of steel. Baffles are not inherently made of
6 steel.

7 Likewise here, there's claim language that talks in
8 terms of flexible deformable material.

9 But because the claim specifically requires
10 flexible deformable material, that means the term applicator
11 base does not inherently -- it is not inherently required to
12 be a flexible deformable material.

13 Next slide.

14 So defendants' definition is contrary to the use of
15 applicator base in the patent. Defendants' definition is
16 certainly not an ordinary meaning of the term applicator
17 base. Plaintiffs' proposed construction is a body having a
18 chamber that receives a cartridge or solution packets.
19 Plaintiffs' construction is consistent with the plain and
20 ordinary meaning in the context of the '445 Patent, and
21 therefore we ask that the court reject plaintiffs' proposed
22 construction and adopt -- I'm sorry. Let me rephrase that.
23 I want to make sure I get that right.

24 So we request that the court adopt plaintiffs'
25 construction and reject defendants' construction.

1 THE COURT: I can construe those two terms
2 plaintiff and defendant pretty well.

3 MR. BURNSIDE: Your Honor, I understood that we
4 weren't going to have replies and sur replies. I'll make
5 this brief since it was raised.

6 This concept, this fundamental concept, and I am
7 not going to belabor this point. Your Honor is familiar with
8 fundamental concepts that you need to construe claim terms
9 consistent with the purpose of the invention is set forth in
10 Phillips case, among others, so I wouldn't argue about length
11 Bausch & Lomb. I will point out it was in our opening brief
12 and could have been responded to long before today.

13 Turning to applicator base. I listened intently to
14 the comments that the defendants' proposed definition is not
15 the ordinary meaning of the term applicator base. Yet
16 somehow the definition, "includes an applicator body having a
17 chamber that receives a cartridge or solution packet," is the
18 ordinary meaning of applicator base.

19 Now, let's think about the word base for a moment.
20 Basis foundation. Something that everybody can identify. A
21 basement of a house. It's the lowest level. It's the
22 foundational concept.

23 The plaintiffs have said that, well, an applicator
24 base includes certain things, such as a chamber. If we are
25 going to say it includes, then we should be all inclusive and

1 make clear that it's a chamber made of flexible deformable
2 material as specifically set forth in Claim 1d which also
3 contains the phrase applicator base.

4 Now, when you look further at the plaintiffs'
5 construction of this term, there is a couple of fundamental
6 problems, which affects many of the terms or the definitions
7 of the terms that the plaintiffs have come up with.

8 First off, in many terms and in one included, they
9 use words liken includes. And other terms they use words
10 like essential, open ended, vague and ambiguous. That cannot
11 be part of any definition of any claim term, includes or
12 essentially is.

13 Further, in order to define applicator base, they
14 use the words applicator. You can't define a term by using
15 all or a portion of the term itself. So the plaintiffs'
16 proposed definition is replete with problems. Number one,
17 it's not the ordinary meaning itself. Number two, it's sort
18 of over reaching, ambiguous and open-ended by the use of the
19 words includes. Tries to define itself by reference to
20 itself by the use of the word applicator.

21 But we do agree on one thing. That we need to make
22 reference to the chamber. Because in the patent itself, the
23 inventor has stated that the applicator base, having a
24 chamber. And then further, the applicator base having a
25 chamber that is made of flexible deformable material. We are

1 simply attempting to come up with a definition that is clear
2 and that is consistent with not only the patent but also the
3 inventor's intention. Thank you, your Honor.

4 THE COURT: Thank you, Mr. Burnside. Okay, let's
5 take a break. A short one.

6 (Off the record).

7 THE COURT: Back on the record.

8 THE COURT: All right. Thank you. Next term.

9 MR. NORMAN: Yes.

10 (Recess taken).

11 THE COURT: I think we were talking about canal.

12 MR. NORMAN: Yes, your Honor. The term canal
13 occurs twice. First in paragraph A, it says, an applicator
14 base having a chamber comprising a top surface with a first
15 opening, a bottom surface traversing into a canal.

16 And then in paragraph B, it says, an applicator
17 having an applicator orifice and being aligned with said
18 canal of said chamber.

19 What we could see by the claim language itself is
20 that the canal is going to be a portion of the chamber.

21 Now, in this particular case, all we know right now
22 from the reading of the claims is that the canal is a region
23 of the chamber.

24 In this case there -- with respect to the term
25 canal, the term canal was not explicitly defined in the

1 patent, so Lexicography doesn't apply and there was no
2 disavowal with respect to the term canal.

3 The ordinary meaning of the term canal is a
4 passageway or narrowing. The defendants' asserted definition
5 is contrary to the claim language. Defendants assert that
6 canal is a channel which begins in the chamber of the
7 applicator, continues through the applicator head ends at the
8 prongs and secures the solution bearing cartridge to permit
9 travel of the solution from the cartridge to the prongs.

10 First of all, that term right there is not an
11 ordinary meaning of the term canal. Not by any stretch of
12 the imagination.

13 So also defendants' proposed definition of canal is
14 contrary to the claim language. The claim language, as I
15 read earlier, indicates that a canal is a region of the
16 chamber. So defendants -- so because no Lexicography or
17 disavowal of the term canal exists, plaintiffs' construction
18 is consistent with the ordinary meaning. Defendants'
19 definition conflicts with the claim language itself and is
20 inconsistent with the ordinary meaning of the term canal.

21 THE COURT: Mr. Burnside.

22 MR. BURNSIDE: Yes.

23 THE COURT: Would you address in the proposed
24 definition by the defendants, or construction, you use terms
25 like secures; the beginning and ending are set forth. How

1 are these additions not confusing or adding new stuff that
2 could be objected to? That's my main concern.

3 MR. BURNSIDE: I'll definitely address that, your
4 Honor. That's my main argument. But let me give you a couple
5 of quick pointers here about their definition.

6 First off, as I mentioned before, they are now
7 using the word essential, saying essentially means. I don't
8 know what essentially means. It's broad and open ended,
9 ambiguous to say the least.

10 I would also point out that they use the term tube,
11 duct or passageway to define the word canal. I believe
12 they are looking at the free dictionary available on the
13 Internet. As I always tell my children nothing on the
14 Internet is accurate, believable or true. I would make the
15 same suggestion here. I have never even heard of the free
16 dictionary until this case.

17 Next. Let's look at the word tube, duct and
18 passageway. The ordinary meaning of a tube is something that
19 round or close to being round and closed. Same with duct .
20 I can give your Honor an example, air duct.

21 Passageway does not have to be enclosed. It
22 doesn't have to be round. It suggests something a lot
23 bigger. And interestingly what they do not have in
24 definition is the word channel.

25 If you look at figure 1a of the patent, the canal

1 is number 17, which at least, according to the directional
2 instruction of number 17, is pointing to that part of the
3 canal which is an adjacent to the applicator head.

4 Within the applicator head is something called
5 internal channel, which is number 21. Again, in keeping with
6 the essential element or the essential element of the
7 invention here, the direct convenient and clean delivery of
8 medicant, you would think that the canal, the internal
9 channel would have to be at least connected if not one in the
10 same.

11 So why not we are now defining the word canal as a
12 channel, which is certainly much more descriptive relevantly
13 so than a passageway is a question that once again, I think,
14 influences litigation strategy and infringement arguments
15 down the road.

16 If we are going to call it a tube, a duct or a
17 passageway, it should certainly be deemed a channel. If
18 anything a channel and canal are one in the same at that
19 point of the invention.

20 Let me get to the point your Honor raised. The
21 patent makes clear that one purpose of the canal is to keep
22 the tube in a stationary position. In other words, to secure
23 the cartridge. That's an essential part of this invention,
24 the clean and accurate delivery of a medicant.

25 If you look at column 6, lines 5 through 7, that's

1 exactly what the inventor said. She said as follows.

2 MR. NORMAN: I'm sorry.

3 MR. BURNSIDE: Column 6 beginning at line 5. It
4 makes reference to the cartridge which traverses and rests in
5 the canal. And this is now the important language: Keeping
6 the tube in a stationary position while being used and
7 applied to the animal.

8 In answer to your Honor's question. An essential
9 function of this canal is to keep the cartridge, which is
10 also referenced as a solution compartment, securely in place
11 so that the medicant will safely conveniently, in a clean
12 fashion, traverse through the canal, traverse through the
13 channel, through the applicator head and through the prongs
14 and directly onto the skin of the animal.

15 Your Honor, if I have addressed that question
16 sufficiently, that's all I have.

17 THE COURT: Okay. Thank you, Mr. Burnside.

18 MR. BURNSIDE: Thank you.

19 MR. NORMAN: Your Honor, we certainly have no
20 problems with adding the term channel to the ordinary
21 meaning. But we are looking at what the ordinary meaning.
22 There's not any particular dictionary definition that is
23 going to necessarily apply. But it's going to be the
24 ordinary meaning. Certainly not going to be inconsistent
25 with dictionary definitions.

1 The language we are proposing for ordinary meaning,
2 there's nothing magical about it. We're trying to propose
3 definitions that are going to be consistent with the language
4 of the patent specification. But the critical element is
5 that the terms have to be given in their ordinary meaning.

6 And when one references the patent specification,
7 the term channel is not used contrary to its ordinary meaning
8 in the specification, even though the recitation to the
9 specification that was made in this column 6. Nowhere does
10 it say a channel as used herein, is something that secures.
11 It's not in there.

12 Moving to the next term.

13 MR. BURNSIDE: Your Honor, if I could be heard on a
14 point of procedure. I understood you wanted to hear from
15 counsel and me and then move. If you're going to entertain
16 surrebuttal, I would like an opportunity as well. I suspect
17 that is not what you want.

18 THE COURT: I understand. To the extent that there
19 is apparent willingness to incorporate your definition along
20 with theirs, then that was important for me to hear. Let's
21 move on to the next.

22 MR. NORMAN: The next is applicator head. The term
23 applicator head occurs three times. First in paragraph, sub
24 paragraph B of Claim 1. And the second two times are in sub
25 paragraph C. An applicator head having an applicator orifice

1 and being aligned with said head and said chamber.

2 The term applicator head is not explicitly
3 defined. And the defendants are not going to be able to show
4 you anywhere in the patent's specification where the term
5 applicator head is explicitly defined. The fact that the
6 term is used in connection with the specification in a
7 discussion of the preferred embodiment, doesn't mean that
8 term is being used in the definition, unless explicitly
9 defined is to be given again its ordinary meaning.

10 I would caution the Court as to any reference to
11 that specification that is not pointing to a definition
12 should be rejected as being a definition.

13 The plaintiffs' proposed definition of applicator
14 head is the front or forward section. Defendants' defined
15 applicator head as a hollow portion of the applicator that is
16 narrower than and protrudes from the chamber and contains a
17 canal which secures the solution bearing cartridge to permit
18 travel of the solution from the cartridge to the prongs.

19 The ordinary meaning of the term head in the
20 context of the claims are going to be the working end of a
21 tool or implement.

22 Of course, a dictionary is a compilation of
23 ordinary meanings of English words. So the term head, of
24 course, has many different plain and ordinary meanings. It's
25 going to be the context of the claim that is going to dictate

1 which of those plain and ordinary meanings apply.

2 So a head might mean, of course, a person's head.
3 Or in the context, if I would say the head of a pin, it would
4 have a very different context. But one of the common
5 definitions of head is going to be the working end of a
6 tool.

7 And by the way, we did use the term applicator.
8 Defendants, I note, did use the term applicator in their
9 definition of applicator head. Despite the fact that Mr.
10 Burnside told you that that's not a proper thing to do, well
11 Mr. Burnside is incorrect for that statement. I don't have
12 any problem with the use of the word applicator in the
13 definition because the Federal Circuit does not prohibit the
14 use of a word in a definition. I am not aware of any Federal
15 Circuit case law to that effect.

16 As a matter of fact, the Federal Circuit can choose
17 to not define a term even if it's a term in dispute if the
18 court believes that the jury is going to understand the term
19 itself more than any definition.

20 So, for example, if the parties disputed the term
21 water, and we're proposing complex names or even just talking
22 about it, you know, H₂O, or spelling that out, the court
23 doesn't have to define the term water. The court could
24 choose -- the jury will understand this term more than it
25 will other terms. So I am not aware of any Federal Circuit

1 principle that says you can't use the term in a definition.

2 Anyway, the ordinary meaning of the term head is
3 the working end of a tool or implement. The plaintiffs'
4 proposed construction is consistent with the ordinary
5 meaning. Defendants' definition is not.

6 Maybe some discussion again of the specification,
7 but again unless it's definitional, the term applicator head
8 must be given its plain and ordinary meaning. So because
9 plaintiffs' proposed instruction is consistent with that
10 ordinary meaning, the court should adopt our definition.

11 THE COURT: Okay, thank you. Mr. Burnside.

12 MR. BURNSIDE: Your Honor, a jury is going to have
13 to determine at the end of the day -- perhaps not. Perhaps
14 your Honor will decide on the motion. But assuming your
15 Honor doesn't decide some of these on motion, the jury is
16 going to have to decide whether there is infringement. A
17 jury, not the Federal Circuit is going to have to understand
18 the claim terms.

19 It just strikes me, when you use the most operative
20 part of a claim term to define itself, that just creates
21 confusion for the future. Notwithstanding federal circuit
22 precedent, it strikes me as so fundamental. I didn't even
23 bother with federal circuit precedent. I am happy to do so
24 now.

25 Defining the applicator head by saying it's the

1 head, it's going to create more confusion. Or perhaps why
2 even define it if it's so obvious it's that that is the head
3 and not so obvious and here is why.

4 Again, we have the word includes, open ended,
5 ambiguous as well. But here's the issue. If you look at
6 figure 1a again, you'll see that the applicator head is
7 number 18. It clearly protrudes from the applicator body.
8 And that is one of the things that we wanted to point out in
9 our definition, that the applicator head protrudes and is
10 certainly not part of the applicator body.

11 And unfortunately, your Honor, and I don't really
12 want to get too much into this, because it violates my
13 fundamental objection. But if you recall from, I believe,
14 page 3 or 4, when I objected to the descriptions or the
15 titles that they were giving to my client's product, they
16 have given the title applicator head a very, very improper
17 and wide meaning, so this is going to be a very big issue at
18 the trial and therefore we need to make sure that the jury
19 understand that the applicator head protrudes from the body
20 of the applicator itself.

21 Otherwise, your Honor, everything else I would have
22 to say is set forth in extensive briefing that we have done
23 and I am not going to reiterate that. Certainly your Honor
24 has read or will read all of those papers. Unless your Honor
25 has a question.

1 THE COURT: No. You can continue.

2 MR. BURNSIDE: Thank you.

3 MR. NORMAN: Your Honor, the next disputed term is
4 aligned. As you used in the claim, aligned means in line
5 with. If you look at -- there are three occurrence of the
6 term aligned in Claim 1. The first is in sub paragraph B, an
7 applicator head having an applicator orifice and being
8 aligned with said canal of said chamber.

9 THE COURT: What I will ask you to do, Mr. Norman,
10 if you look at the competing definitions. They are really
11 very short. So how is in line with different from lined up
12 with?

13 MR. NORMAN: Okay.

14 THE COURT: And how is position orientation better
15 than connected to?

16 MR. NORMAN: Okay. So the defendants' suggestion
17 of lined up is consistent with the with the ordinary
18 meaning. I don't believe there's any difference with lined
19 up or in line with. I just think those are different ways to
20 phrase things. We don't have any problem with that. We
21 certainly believe that lined up with would be consistent with
22 the ordinary meaning.

23 The difference is connected. Now the term aligned,
24 the ordinary meaning of an aligned does not mean connected.
25 Now something might be aligned and it might be connected.

1 Something might be connected without being aligned and it
2 might be aligned without being connected. If something is
3 both aligned and connected, it's going to required both those
4 English words to describe that relationship.

5 Now the term aligned was not explicitly defined in
6 the patent specification and certainly the word aligned does
7 not mean in -- does not mean connected with.

8 And now I do want to point out that with respect to
9 the term aligned, as with all the other terms that have been
10 discussed so far, defendants keep referring to the preferred
11 embodiment. And I would again direct the court's attention
12 to the GE Lighting case where the Federal Circuit rejected
13 the approach of taking limitations that were found in the
14 preferred embodiment and somehow jamming them into the claim
15 by doing so by defining a term.

16 And the Federal Circuit said you cannot do that.
17 You must define a term to be given its plain and ordinary
18 meaning. And the plain and ordinary meaning of aligned, it
19 absolutely does not require the word connected.

20 THE COURT: Okay. Let's hear from Mr. Burnside.

21 Just talk to me about the connection issue.

22 MR. BURNSIDE: I will, your Honor. In that context
23 if I could make a brief comment about this notion about the
24 preferred embodiment that we just heard about in connection
25 with the word connected.

1 You know, the judges in this district have been
2 very clear simply because an inventor decides to devote 70
3 or 80 or 90 percent of her or his or its patent to a section
4 called preferred embodiment, doesn't mean everything in that
5 section preferred embodiment, particularly looking for words
6 to make clear that it's a preferred embodiment over the
7 essential claims itself.

8 Just because page is 4 5, 6, 7 and 8 and part of 9
9 comes under the captioned preferred embodiment doesn't mean
10 everything in that there is a preferred embodiment.

11 Again, I will just remind your Honor about the
12 Phillips case. These claims terms being construed with the
13 inventor's purpose which is set forth in that section called
14 preferred embodiment.

15 THE COURT: Well stick to the point that aligned
16 does not necessarily mean connected.

17 MR. BURNSIDE: Okay. Your Honor, if you look again
18 at figure 1a, and in particular then if you also can look at
19 that and also look at the description of the various
20 components of 1a, in particular column 6. What it says is
21 that the applicator head, which is number 18, is in line and
22 connected to number 19, which is applicator orifice.

23 It also goes on to say cartridge aperture in 31 in
24 line and connected with the applicator head. That's why we
25 come with what I consider to be a very logical meaning that

1 it's in line with and connected to.

2 Again, if you look at the essential invention here,
3 it is the easy clean flow of medicant from one component to
4 the next component until we get to the dog's skin.

5 So I don't even see how this should even be a big
6 dispute.

7 I would suggest, your Honor, in line with what
8 counsel said, that I think I omitted the word with from lined
9 up and connected in, it should say to be grammatically lined
10 up with and connected to. So I think I omitted the word with
11 from my definition, which counsel made clear in his comments
12 a couple of moments ago.

13 THE COURT: Okay. I'll make a note of that. All
14 right.

15 MR. BURNSIDE: Unless your Honor has any questions,
16 I have nothing further.

17 THE COURT: You can move on.

18 MR. BURNSIDE: Thank you.

19 MR. NORMAN: Yes.

20 THE COURT: I think we are coming to the fight, the
21 prong or prongs?

22 MR. NORMAN: Yes, your Honor. I guess what I could
23 do is--

24 MR. BURNSIDE: Your Honor, I notice this-- it's one
25 o'clock and this is going to take substantial time. Maybe

1 it's the best time to break.

2 THE COURT: You're probably right. We'll adjourn
3 right now and be ready to roll right at two o'clock.

4 (LUNCH RECESS TAKEN).

5 THE COURT: Good afternoon. Okay, let's go.

6 MR. GARLOCK: Your Honor, the procedural standpoint
7 it seems, during the morning session, a number of times, we
8 would appreciate an opportunity to rebut. And the structure
9 is such as, you know, we go and then they go and we prove to
10 them, either we carve out an opportunity to respond to rebut
11 what they say in their remarks perhaps, or we have confine
12 terms and about to do five more. That perhaps they would go
13 first in, you know, the second five so that we'll be able to
14 respond to what they say it and that way create a fairness
15 that might benefit the Court.

16 MR. BURNSIDE: Your Honor, with regard to the
17 latter suggestion, I note we are approaching the more
18 material terms and it is the burden of the plaintiffs to deal
19 with in terms of their own patent at the outset and I would
20 decline that invitation.

21 THE COURT: Let me just say. To me, the real nub
22 of this, and I use that term meaningfully, is this prong
23 single, multiple, and so on. This is where we had the motion
24 to amend and this is where we have what appears to be, from
25 the way the briefs are written, the issue that is of most

1 urgency to the parties. So I don't care who goes first. I
2 just want to hear both sides. And whomever goes first is
3 going to have a chance to rebut whomever goes second. And
4 you know we'll just do ping pong back and forth so I could
5 hear both sides both as objectively and affirmatively and
6 then rebutting.

7 I think if we spend the rest of our time together
8 really focusing on that issue, whatever we have not covered
9 we'll throw on at the end. Why don't we get right to in
10 terms of the motion to amend. That really is wrapped up in
11 the meaning of prong or prongs. So let's hear from the
12 plaintiff on that and let's hear from the defendant and here
13 back from the plaintiff and here back from the defendant and
14 then I'll call a halt.

15 MR. GARLOCK: Thank you, your Honor.

16 MR. NORMAN: Thank you.

17 THE COURT: Thank you.

18 MR. NORMAN: The next term is prong member just
19 from although we hit it in claim construction, what we
20 presently have up is going to be the Power Point, which is
21 much shorter Power Point that we given the Court with respect
22 to the motion to correct.

23 THE COURT: And it seems to me that the law is
24 pretty straight forward what I can and cannot do and I have
25 had law from both sides about district court judges who stray

1 into the dangerous territory of fixing things. I don't think
2 you have got to give me the law again, give me your argument
3 on why this is so straight forward a mistake as it were that
4 I should be able to do something with my magic wand. Okay.

5 MR. NORMAN: Yes, your Honor. Okay. So the term
6 prong in some form of the word or form of the phrase occurs 4
7 times in Claim 1. The first time is.

8 THE COURT: It appears elsewhere throughout too as
9 well, right?

10 MR. NORMAN: Yes, your Honor. But the key, the key
11 to be decided here is is there an error in the claim. That's
12 going to be the key.

13 THE COURT: Yes.

14 MR. NORMAN: So the first occurrence at least one
15 prong member. Now, the second three occurrences are all
16 prefaced with the word said. Move to the next slide. The
17 use of the word said in a claim refers to an earlier-- to an
18 earlier use of the term in the claim. That is the Intamin
19 Ltd. v. Magnetar Technologies Corp. 483 F.3d 1328 and 2007,
20 Fed Circuit. And again the first occurrence is the-- at
21 least one prong member having an internal channel therein.

22 The second occurrence is said prong member, by use
23 of the word said we know that there must have been a previous
24 reference in the claim to the term prong member. And we see
25 it, so the second occurrence, said prong member is

1 necessarily referring back to the at least one prong member.

2 We also see some other words surrounding that.

3 Where it says said delivery and aperture. This is second
4 occurrence said delivery and aperture of said internal
5 channel of said prong member. Those are two other terms then
6 it is going to have been previously used. The delivery and
7 aperture, the said delivery and aperture, and said internal
8 channel are both features of the at least one prong member.
9 So that's the first occurrence. If we look at the third
10 occurrence there is said prongs plural.

11 Now, the use of the word said tells the reader
12 that, and according to Federal Circuit case law, that the
13 term must have been previously used in the claims. But we
14 don't see prongs plural anywhere. So let's-- now a normal
15 reading of that would be the closest thing to said prongs
16 going to be said prong member. Or at least one prong
17 member. So right now it tells the reader, well, it is
18 probably an error and it's probably going to be that prior,
19 that earlier use of the at least one prong member.

20 Let's look at the fourth occurrence. The fourth
21 occurrence is said prong. Prongs in the singular. And it's
22 the prong-- it's not prong members. But it says said
23 solution to travel through said internal channel of said
24 prong. Well, the only internal channel that has been
25 mentioned anywhere in the claim is the internal channel of

1 the at lease one prong member.

2 So it is clear that the fourth occurrence is
3 directed to the at least one prong member. From a reading of
4 the claim then it is going to be clear that the said prongs
5 necessarily referring to the same item. The at least one
6 prong member.

7 THE COURT: Now that's inherent though is that term
8 prong member morphed into the term prong, correct? Or not?

9 MR. NORMAN: And that is something I'm going to
10 point out. I will show the Court that this, the patent
11 specification and also in the prosecution history the terms
12 prong and prong member are used interchangeably throughout
13 the patent, and in the patents prosecution history as well.

14 THE COURT: Just a yes or no. Do the defendants
15 agree that these terms are used interchangeable? In the
16 patent-- just a yes or no.

17 MR. BURNSIDE: No.

18 THE COURT: Thank you. Go ahead.

19 MR. NORMAN: I will direct the Court's attention to
20 the summary of the invention of the '445 patent and that
21 occurs in column 2 lines 51 to 67. And this is a discussion
22 of the present invention, not in the context of the preferred
23 embodiments, but rather the present invention. And the claim
24 says at least one prong member having a internal channel and
25 prong/delivery and aperture is constructed within the direct

1 delivery applicator. The prong, and this is prong not prong
2 member. And the term prong has not yet occurred anywhere in
3 this summary of the invention either. It says the prongs
4 constructed having appropriate lengths, so that the prongs
5 delivery, now that is prongs, but that is a prong's
6 apostrophe S. Again looking at prong singularly, the prong
7 delivery and aperture substantially contact the animal's
8 skin. So if we look at the-- where it is the delivery and
9 aperture, the delivery and aperture is going to be the at
10 least one prong member. So we see in the summary of
11 invention the term prong member and prongs is used
12 interchangeably.

13 Now, one other thing, if the Court would look to
14 column 6, and I don't have this up on a slide. But column 6
15 line 17 of the '445 patent says. At least one prong member
16 20. So talking in connection with the preferred embodiments
17 that going to be column 6. I'll just read it. It says at
18 least one prong member 20. And then it goes on to say
19 preferred embodiments, there are a plurality-- that is not
20 what is up on the screen what I was just read is column 6.

21 THE COURT: Yes.

22 MR. NORMAN: What is shown in the drawings of the
23 preferred embodiment all of them have a plurality of prongs
24 or a plurality of prong members same elements. And by the
25 way elements reference numeral 20 sometimes in the patent

1 refers to prong member. And sometimes it refers to prong.
2 Or sometimes, because it's talking about a preferred
3 embodiment that has multiple prongs that figure 1 A we have
4 shown the Court already. That is as I pointed out does have
5 multiple prong members. Sometimes it refers to those prong
6 members as prong members 20 and sometimes prongs 20. So
7 there are interchangeably with respect to the numeral 20
8 itself. And that is by referencing a-- by referring to a--
9 by reference number we know that we're talking about the very
10 same elements.

11 Now I'll direct the Court's attention to column 8
12 of the patent. And this is going to be the last few
13 paragraphs of the patent specification before the claims.
14 And again in this section here the patent is not talking
15 about preferred embodiments where the Fed Circuit says, you
16 are absolutely not to incorporate or add limitations from the
17 preferred embodiment into the claims. Here this particular
18 section of the patent is talking about the invention--
19 present invention and this language is a little bit
20 different. Beginning on line 29 of column 8. Significant
21 advantages are realized by practice of the present invention
22 the key future of the direct delivery applicator and
23 advantages derived include in the combination the features
24 and advantages set forth below and list some items. Item 3
25 says, at least one prong member. And preferably a plurality

1 of prong members. Each of which has an internal channel
2 therein with a fine delivery and aperture associated and
3 aligned with the applicator orifice.

4 The defendants are going to argue that the patent
5 specifications says that preferably the direct delivery
6 applicator has at least three prongs. That's true. The
7 patent specifications does say that preferably you have three
8 prongs. But right here we have in the column-- in the claim
9 at least one prong and that language is crystal clear. Here
10 this is again talking about the invention and it says, at
11 least 1 and preferably a plurality of prong members. The
12 writer here could not have been clearer that the invention is
13 not limited a plurality of prongs.

14 Next slide please. Now, in the turning to the
15 prosecution history. In the prosecution history of the
16 patent, this was an amendment, this was an amendment that was
17 filed in connection. And in here there's another statement
18 concerning the present invention. Here it says, the present
19 invention-- I won't read the whole thing I'll skip to the
20 third sentence it says. At least one prong member having a
21 internal channel and prong/delivery and aperture is
22 constructed within the direct delivery applicator. The
23 prongs constructed having an appropriate length so that the
24 prong delivery and aperture substantially contact the
25 animal's skin being the fur.

1 So I will note that you have at least one making it
2 clear that this is in the-- this is in the amendments were
3 the plurality. I should say where the plural word prongs was
4 accidentally included in the claim. Now they're talking about
5 the present invention and we see at least one prong, all
6 singular here when talking about the invention. And although
7 it yet still uses the term prong. So some places are using
8 prong member, but now using prong in the singular. But, I
9 mean, I should say that in all cases using the singular in
10 this particular paragraph. But you see that prong member and
11 prong are used interchangeably.

12 One other thing that defendants do in their
13 opposition and what plaintiffs' argue in their opposition is
14 they direct the Court to laboratory notebooks produced by
15 plaintiff Marni Markell Hurwitz. Well, the only problem with
16 that is that laboratory notebooks are not part of the test
17 for determining whether an error occurs in the claims. If we
18 go back to the case, yes, this says district courts can
19 correct the patent if the correction is not subject to
20 reasonable debate based on consideration of the claim
21 language and the specification. And, two, the prosecution
22 history does not suggest a different interpretation of the
23 claims. So I've gone through the entire patent, which would
24 be the correction reasonably based on consideration of the
25 claim language and the specification.

1 Now I do note that the reasonable debate must be
2 limited to the language of the patent itself. The item two
3 that's not the prosecution history cannot come up with a
4 debate. Look at, does the prosecution history suggest a
5 different interpretation-- that's not even part of the
6 reasonable debate prong. But then also those are the only
7 things to consider. There's the test that has to be based on
8 the record. Just as we could not use any type of extrinsic
9 evidence testimony of the inventor or lab notebooks to show
10 some other intent, because that's not what the test is based
11 on. The test has to be based on the patent itself. And the
12 Court can then consider the prosecution history for this
13 other limited purpose.

14 That is my argument.

15 THE COURT: Thank you. Mr. Burnside.

16 MR. BURNSIDE: Your Honor, I would note that the
17 reasonable debate we are engaging in now already lasted close
18 to 30 minutes and I'll probably double that time.

19 THE COURT: That is not a good way to start.

20 MR. BURNSIDE: A reasonable debate.

21 THE COURT: I understand, but I would never tell
22 the Judge you would take twice as long.

23 MR. BURNSIDE: I am not going to your Honor I am
24 not going to take twice as long.

25 THE COURT: Okay.

1 MR. BURNSIDE: Let me start with the motion.

2 THE COURT: Well, let's start with why reasonable
3 minds can disagree. Okay.

4 MR. BURNSIDE: Okay. Sure. There are 53
5 references, either pictorially or in writing to prongs in the
6 plural in this patent.

7 THE COURT: Now, when you say pictorial you mean
8 they have little numbers that use the word prong?

9 MR. BURNSIDE: Schematic and/or the written
10 material itself.

11 THE COURT: And the word says prong or prong
12 member?

13 MR. BURNSIDE: Either shows more than one prong or
14 specifically says prong or prong members.

15 THE COURT: Stick to the prong or prong members,
16 because we're not being asked to amend drawings we are asked
17 to amend--

18 MR. BURNSIDE: Roughly 49 references to prongs or
19 prongs members plurally in the plural. I am not repeating
20 this, your Honor has read it and we made references to lab
21 books and schematics. There are many, many references to
22 prongs and prong members throughout all material, your Honor,
23 given and including the material being given and cited today.

24 THE COURT: Off the top of your head, if they are
25 interchangeable, if they are not interchangeable why aren't

1 they interchangeable? And what does the prong refer to that
2 the prong member doesn't refer to and vice versa.

3 MR. BURNSIDE: I want to be clear when I said no
4 before. I thought the question was does the word prong and
5 prong members is the same. We agree that prong and prong
6 member is the same. Or prong and prong members.

7 Maybe I misunderstood your question before.

8 THE COURT: Yes. What comes to my mind is
9 something from grammar school. All insects are bugs, but not
10 all bugs are insects. And I remember sitting for two years
11 of time trying to figure out how that worked.

12 So all prongs are prong members and all-- every
13 prong is a prong member for purposes of this case? Yes?

14 MR. BURNSIDE: Yes.

15 THE COURT: All right.

16 MR. BURNSIDE: I would add the use of the word
17 member implies plural even when you say prong member, if
18 there's not more than one prong-- it is like me making
19 reference to that I am a member of the Bar Association and
20 clearly the Bar Association comprises of more than one.
21 Otherwise there's no need to say a member of something. By
22 saying prong member you are suggesting if not saying there's
23 more than one member there's more than one. Otherwise you
24 wouldn't need to say prong member to begin with.

25 I would also point out that this so-called simple

1 mistake was not caught for the four years that the patent has
2 been issued and for the three years this litigation been
3 pending throughout the patent submissions to this Court and
4 through the first rounds of briefing and throughout the
5 amended Markman briefs provided by-- it wasn't until the
6 Markman brief and all of a sudden this obvious error became
7 apparent to even the plaintiffs and all of the attorneys
8 representing the plaintiff. Or plaintiffs, excuse me.

9 I would also suggest to your Honor that as I
10 started at the very outset when talking about the first claim
11 the essential invention here is for this device at its end
12 point to touch the skin and to separate the hairs to further
13 allow the skin to be touched by this device, to allow the
14 clean and accurate and convenient disbursement of the medicant
15 to the body of the dog. That's the essential invention
16 here. One prong doesn't accomplish that. Three prongs does,
17 six prongs even better.

18 So if we're going to look at the essential
19 invention here, which is to make sure this device gets right
20 to the skin and separates the hair of the dog to allow that
21 that to happen, once again one prong will not do it, which
22 further supports that intent of this entire invention has
23 always been multiple prongs. As we cited so many times in
24 the patent itself.

25 Now, you could take all of what I said and agree or

1 disagree and take all what the plaintiffs said and agree or
2 disagree with it, but clearly in light of all of the briefing
3 and clearly in light of all of the evidence presented on both
4 sides it a reasonable debate. And it is not your Honor's job
5 to decide who is right. It's your Honor's job to decide is
6 there a reasonable debate. And clearly there is here.
7 Otherwise we wouldn't have spent all this time and effort to
8 get to correctly point out that one of the key terms in the
9 patent prong and prong members.

10 I would also like to address this said issue. Now
11 I didn't have a chance to submit a surreply and that's why we
12 haven't respond and I will respond now. And it is very clear
13 the importance of the word said. Let me direct your Honor's
14 attention to claims 67 and 68 of the patents.

15 THE COURT: Okay.

16 MR. BURNSIDE: Now, let me read from number 6, a
17 direct delivery applicator as recited by Claim 1.

18 Right then and there they are referring back to
19 Claim 1, as it has to because it's a dependent claim. And
20 they want to say, wherein each of said pronged member --
21 clearly that's a mistake. It should be prong members. And
22 that's confirmed by number 7 wherein said prong members,
23 again referring to Claim 1. And then Claim 8 says once
24 again, wherein said prong members, again referring to Claim
25 1.

1 So not only do we have the use of prong members in
2 Claim 1, but we also have it in the use by the words said in
3 Claim 6, 7 and 8. Which basically raises the following
4 simple issue, which should really address the motion very
5 easily, and that is, which is right? The four references to
6 prong members or prongs that I just pointed out? Or the
7 three references to prong that the plaintiffs have pointed
8 out. I'm not sure what the answer is. I know in my heart
9 what the answer is. But from the point of view of the
10 standard that governs this motion, is there reasonable
11 debate?

12 I would argue to your Honor that the mistake here
13 is the use of the words prong. Not the use of the word
14 prongs or prong members. At a minimum, there is a critical
15 debate here, which automatically removes this from the
16 province of your Honor and puts it in the lap of the PTO.

17 So let me turn if I could, your Honor, to the
18 actual definition. As you could imagine, I have a few
19 comments about that as well. Let me start by pointing out
20 once again that the words essentially and includes are used
21 by the plaintiffs in their definition which inherently is
22 ambiguous and open ended. At a minimum those have to be
23 removed from any definition.

24 I would also point out this. They claim that the
25 definition of prong member is any projecting part.

1 Well, if you look at figure 1a, any projecting part
2 would also include the applicator head, which is a separate
3 component, if you will, of this invention. That's number
4 18. It would include the internal channel, number 21 from
5 that figure because that also protrudes from the body of the
6 applicator.

7 It would include the shield which is number 25,
8 which also protrudes from the applicator body. It would
9 include the applicator orifice, which is number 19, as well
10 as flap on a different claim. But nonetheless-- but these
11 are all things that protrude from the applicator body
12 itself. And therefore by saying the prong member is anything
13 that protrudes that, now you are defining prong member to
14 essentially include applicator head, internal channel shield,
15 applicator orifice, etc. And if I remember correctly from
16 earlier arguments today, anytime the defendants wanted to
17 define something by what it included, they objected. So they
18 can't have it both ways.

19 You can't explain a claim term when it pleases you
20 and limit a claim term when it pleases you.

21 The use of the word projecting part in their
22 definition is completely inappropriate.

23 Now one final comment, your Honor. Again, I am not
24 going to repeat everything that's in our briefs. I would
25 make this one final comment. Unfortunately I refer back to

1 the motion for this one very brief comment.

2 I carefully listened to counsel, and he said this
3 twice, "probably an error." If it's probably an error in his
4 mind, that's not something that is so obvious that could not
5 have been missed. Even he thinks it's probable, but that
6 doesn't mean definitively is. And certainly it doesn't
7 suggest a simpler error that the record overlooked and
8 therefore it needs to go back to where it belongs, which is
9 the PTO.

10 Thank you, your Honor.

11 THE COURT: Okay. Thank you.

12 MR. NORMAN: Your Honor, I guess I'll address this
13 last point first. When I said probably an error, I was
14 looking solely at the third item itself in Claim 1. Turn to
15 Claim 1. As I said, upon the reading merely of the third
16 occurrence -- I'm sorry. What I told the Court is, the third
17 occurrence-- just this reading of the third occurrence said
18 prongs. That one reading the claim would say that's probably
19 an error. Because there is no reference to any plural
20 prongs. And then I said once you get to the fourth
21 occurrence, just looking at the claim language, and I do note
22 Mr. Burnside did not address Claim 1 at all.

23 The fourth occurrence said prong confirms there's
24 going to be an error, because now we see that the term prong
25 member and prong starts to give us a better feel that this is

1 a term that is used interchangeably. The patent
2 specification confirms that the terms prong and prong member
3 are used interchangeably. Therefore, the said prongs, that
4 third occurrence, must be referring to at least one prong
5 member first occurrence.

6 What I am saying is, a review of the patent Claim
7 1, we are going to be more than pretty sure, we're going to
8 be fairly confident that there was an error and what that
9 error was. A reference to the patent specification, where
10 the patent specification talks in terms of the invention as
11 being at least one prong member confirms that there is no
12 reasonable debate.

13 Now, whether there are errors in others. Let's
14 pull up some of these other claims. Whether there are errors
15 in claims -- I forget the claims that they were looking at,
16 Claims 7, 8 and 9.

17 THE COURT: I think it was the second line of six,
18 wherein each of said prong member comprises--

19 MR. NORMAN: Well--

20 THE COURT: I think Mr. Burnside said probably each
21 of said prong members. Am I right about that?

22 MR. BURNSIDE: Yes, your Honor.

23 THE COURT: Yes.

24 MR. NORMAN: And that 6 looks like there is an
25 error in 6. We are not asking the Court to correct any error

1 in Claim 6. And whether there are errors in these other
2 claims that's not really the issue. The issue is going to
3 be-- let's look at Claim 4, if we are going to be looking at
4 dependent claims. Claim 4 says a direct delivery applicator
5 as recited by Claim 1 comprising of at least three prong
6 members.

7 Now Claim 4 requires at least three prong members,
8 this is a dependent claim; a dependent claim recites all of
9 the limitations of the independent claim and necessarily
10 limits the scope of the claim.

11 The additional limitation with Claim 4 is that
12 there will be at least three prong members. Which also
13 requires that Claim 1 does not require the presence of at
14 least three prong members as Mr. Burnside asserts. So I mean
15 Claim 4 is going to further confirm what the language of
16 Claim 1 is. But I do note, Mr. Burnside could not address
17 Claim 1 itself. And look at the internal inconsistencies of
18 Claim 1 with respect to that term. And so we know that there
19 was an error in Claim 1. And we know what that solution
20 was.

21 With respect to Mr. Burnside's argument that, well,
22 because our error wasn't found, well then it can't be an
23 error. Well under that type of a test there could never be
24 an error in a patent in order for there to be an error that
25 the Court can correct. The error necessarily wasn't caught

1 beforehand.

2 Also, Mr. Burnside argues that because he presents
3 an argument, then the argument must be a reasonable debate.
4 Now the case that we cited originally, the CBT Clint Partners
5 (ph), that was argued at the district court level. And not
6 only was it argued at the district court level, it was argued
7 at appeal. I am guessing there was more argument applied to
8 that since it went both at the district court level and up to
9 the Court of Appeals, that the defendant in that case was
10 making an argument.

11 Now the fact that they make an argument still does
12 not mean that it is a reasonable argument, that it's subject
13 to reasonable debate. Again, I will encourage the Court to
14 consider the claim language.

15 With respect to the particular definitions. We are
16 perfectly comfortable as to any of the definitions that have,
17 that preface with essentially or including. Those do not
18 need to be in the definitions. I would even say they don't,
19 they shouldn't be in the definitions. And we really haven't
20 argued -- I shouldn't say we really haven't, we absolutely
21 have not argued for those words to be included. And I don't
22 believe it is in any of the briefs since our-- since our
23 amended opening brief.

24 And then with respect to the definition of prong,
25 that it should be a projecting part. That is the definition

1 of a prong. A prong is a projecting part.

2 We are certainly not saying that the claim requires
3 or covers any projecting part. The claim has specific
4 requirements in it. With respect to this prong. Not
5 definitional, but rather requirements that are in the claim
6 that we will have to prove. For example, it's going to be at
7 least one prong member having an internal channel therein.

8 The prongs going to have an internal channel. But
9 that's not a definitional-- the internal channel is not what
10 defines prongs. We apply the ordinary meaning for the term
11 prong. Or the term prong member.

12 So although this particular claim requires the at
13 least one prong member to have an internal channel that's
14 still not the definition. That will be something we are
15 going to have to prove. Of course, the accused product does
16 have a prong member with an internal channel therein. And
17 it's going to have the delivery of it.

18 Not that I mean to be talking now -- I'm just
19 saying that's not going to be an argument that we -- we're
20 not going to be making any type of an argument that for us to
21 prove infringement that we're going to be disregarding the
22 internal channel or the delivery of it. Of course, there are
23 requirements. But as far as prong it only means projecting
24 parts.

25 THE COURT: Okay.

1 MR. BURNSIDE: Very briefly, your Honor?

2 THE COURT: Very brief.

3 MR. BURNSIDE: Your Honor, I think that counsel has
4 sort of misstated my argument. One part of it. We're not
5 saying that simply because something has not been caught for
6 years that there can be no possibility of an error. The
7 point of the matter is that they went to great lengths in
8 their briefs to say that this is that obvious. Well, it's not
9 that obvious otherwise it would have been caught a lot
10 sooner.

11 Given all that's happened with this application and
12 the prosecution history and the lab books and so on and so
13 forth, and if what they're saying now is that they will agree
14 to delete any projected part, yes, they'll indicate that the
15 prong however you define or prong members-- however you
16 define it does protrude-- we're fine with that. But as it
17 was submitted we're not fine with that.

18 Let me make my one final point. Demonstrating that
19 Mr. Slocum is more than worthy to handle some of these other
20 material terms on his own later on. He pointed out to me
21 that said prong members is referring to either Claim 1 or
22 claims--

23 THE COURT: Let me stop you. You're suggesting
24 that Mr. Norman, when he was talking about taking out
25 language essentially etc, etc, or taking his arguments as a

1 whole made these shifting positions to one that is now
2 espoused in the brief-- taking a less defined position? Is
3 that what the position is? What position did you hear him
4 espouse just now that you can live with?

5 MR. BURNSIDE: Well, your Honor, to back up a
6 moment to make it clear. And to make sure that we all
7 understand each other. I don't want to say something that is
8 not accurate, or attribute to something that's not accurate
9 to counsel.

10 I thought that he said that the use of the word
11 includes essentially should not be in there. And the problem
12 by having it say includes any projecting part, it suggests
13 that prong members includes some of those other components
14 that I mentioned before. If he's now saying, which I heard
15 and again I'll stand corrected if I've misstated it.

16 If he's saying that a prong member itself is a
17 projecting part from something, either the applicator head or
18 from the applicator body then I would agree with that. That
19 part at least. I still take issue with the other parts we've
20 been arguing about plural and so forth. But what I think what
21 he's saying is now is that it doesn't cover any projecting
22 part, but that the prong member is a projecting part-- which
23 I agree.

24 MR. NORMAN: Yes, I am certainly-- I am certainly
25 saying that we do not need to say essentially any projecting

1 part. I am saying a prong member is-- by definition is a
2 projecting part.

3 THE COURT: Okay.

4 MR. BURNSIDE: All right.

5 THE COURT: Okay.

6 MR. BURNSIDE: Finally, your Honor, let me just go
7 back to claim 6. It says, "each of said prong member."

8 Now we all recognize that that's a clear error
9 because it should say prong members, regardless of how you
10 view the rest of it. Just by simple grammar. That's an
11 example of a very simple a mistake-- which your Honor could
12 correct in a heart beat, regardless of the passage of time.

13 But now let's go to 7 and 8, and as Mr. Slocum
14 pointed out to me as I sat down 11, 12, 13, 14, 15 and 19,
15 which all make reference to either Claim 1 or a dependent
16 claim which also refers to Claim 1-- each one of these says
17 prong members. So throughout the dependent claims the
18 inventor is clearly referring back to Claim 1, indicating
19 that it's in the plural not the singular.

20 Thank you.

21 THE COURT: Now, it is still your position-- all
22 though you said in your heart of hearts really you think it
23 is really the other way than plaintiffs say. You're not
24 arguing that it's the other way. You're saying it's not
25 capable, it being the claim language is not capable of

1 correction by me to turn the plural into the singular?

2 MR. BURNSIDE: That's part of it.

3 THE COURT: Where does it appear and where it has
4 been challenged?

5 MR. BURNSIDE: Correct. And then I would go on to
6 say that prong, prongs or prongs members has to be more than
7 one.

8 Now, Mr. Norman made reference to Claim 4 and said
9 that has to have three prong members because it has to be
10 more of a limitation than Claim 1. So that maybe in
11 retrospect Claim 1 should be more than one prong member or a
12 series of prong members which therefore allow it to be two,
13 which better accomplishes the essential invention than one
14 single prong. Because at least two has a better chance of
15 separating the hair to allow the medicant to be delivered
16 directly to the skin, which is what this invention is all
17 about.

18 THE COURT: Is the prong member and the description
19 in the referral back and some of the claim language talking
20 about the as it were impregnated prong member delivering the
21 medicant, may be accompanied by other prong members that
22 don't have the medicine in them? Is that essentially what
23 we're talking about? Not to use a bad word like essentially,
24 but is that the part of the essence of the device? Part of
25 the essence of the device? You could have a lot of prongs

1 but at least one has to have medicine in it?

2 MR. BURNSIDE: That's a very interesting thought,
3 your Honor. Candidly I hadn't given that thought. But on my
4 feet I'll be happy to. If what you're suggesting is multiple
5 prong members, one of which delivers the flea and tick
6 ointment.

7 THE COURT: The at least one of which.

8 MR. BURNSIDE: And then there's others in addition
9 to that that helps separate the hairs. I think that that
10 does accomplish the essential invention of at least
11 disbursing the hairs to let those prongs that do deliver the
12 flea and tick treatment to actually get to the skin.

13 THE COURT: And could that also be like you've got
14 Tylenol, and got really strong Tylenol, and you have really,
15 really very strong Tylenol. The flexibility to have one
16 prong member or maybe two or three because you're really
17 whacking the animal with a lot of medicine? So this is the
18 extra strength version. Is that something else, that's not
19 so much covered but a possibility of the within the
20 invention?

21 MR. BURNSIDE: Well--

22 THE COURT: I'm just saying that there are a lot of
23 ways of practically looking at why this language is the way
24 it is and what the aim of the invention is-- which kind of
25 further confuses the issue, because the more ways that you

1 could read this the more obvious the argument that you're
2 making is-- which is you can't know.

3 MR. BURNSIDE: Your Honor, that's a practical
4 observation, your Honor. Unfortunately if you look at all of
5 the evidence, the lab books, the diagrams, the patent itself
6 and the prosecution history, the amendment to the patent,
7 there is really nothing to suggest that in the inventor's
8 mind-- at least that she was looking to do sort of the extra
9 strength Tylenol analogy that you're pointing out. So really
10 it's hard to say. And I agree with you that it does make it
11 more complicated and more confusing. So I'm not sure if
12 that's an answer for you.

13 THE COURT: No, just going back to the simple
14 problem of whether or not one prong as opposed to at least
15 three prongs.

16 MR. BURNSIDE: Or two prongs. That still works.
17 So it is either one prong or a series, the series could be
18 two under Claim 1. Three, under Claim 4 and so forth. And
19 again that's very consistent with essential intent of this
20 invention.

21 THE COURT: And you reject the idea that it can be
22 one prong with the potential for more than one prong?

23 MR. BURNSIDE: I do. Because that doesn't
24 accomplish what the improvement over the then currently
25 existing coverage.

1 THE COURT: Okay. I think that we've pronged that
2 to death and so let's move on.

3 MR. NORMAN: Very brief.

4 THE COURT: Very, very brief. Based only on my
5 last colloquy.

6 MR. NORMAN: Okay. Well, the reason that can't be
7 the case, your Honor, that you cannot have a scenario-- you
8 cannot read the claim to be meaning a series of prongs only
9 one of which has the type of internal channel, is because in
10 one occurrence where prongs are mentioned in the plural in
11 the claim, the claim specifically says, to facilitate release
12 of said solution from said cartridge and through said
13 prongs. You can't have a prong that doesn't have solution
14 going through it in that claim language. The solution is,
15 and there's-- that's discussed in the claim as going through,
16 required to go through only one prong member. Because
17 there's only one internal channel that's discussed anywhere
18 in the claim. Only one internal channel. So that's not a
19 possibility. And there's no place in the specification that
20 suggests a prong that does not have an internal channel for
21 release. With the rest of it, your Honor, we'll rely on our
22 brief.

23 Our brief talks about an alternative motion-- an
24 alternative just the claim construction. Claim construction
25 doesn't require a reasonable debate. That's going to be what

1 one of ordinary skill in the art. Reading this language.
2 Reading the Claim 1, ordinary skill in the art, would
3 understand that prongs in that case is also prong member
4 singular.

5 Thank you, your Honor.

6 THE COURT: Okay. So we've talked about what prong
7 member and what prong members mean and the fact that they can
8 be interchangeable and I think we've captured the parties'
9 argument.

10 Let me just clarify what you just said, Mr.
11 Norman. Are you saying that every prong in this invention
12 has to have medicine running through it?

13 MR. NORMAN: Your Honor, I'm not saying that the
14 claim requires the absence of a prong through which no
15 medicine passes. It doesn't require that absence of such a
16 prong. What I am saying is the specification never mentions
17 a prong through which-- in this sense, a prong or prong
18 members that doesn't have an internal channel. And that the
19 third occurrence of claim-- the third occurrence of prongs in
20 Claim 3 wouldn't lend to that requirement.

21 THE COURT: Got it.

22 MR. NORMAN: The claim is an open ended claim. So
23 if someone could get around the patent by having a single
24 prong along with some prongs that have no medicine going
25 through it. I mean, the addition of a dead prong isn't going

1 to get someone away from the scope of the claim.

2 THE COURT: Got it.

3 MR. NORMAN: That's what I'm saying.

4 THE COURT: Okay. What else do we have to cover,
5 gentlemen?

6 MR. NORMAN: The next term, your Honor, is delivery
7 aperture. This is in slide 4. The term delivery of aperture
8 occurs twice. In the context of Claim 1. The delivery
9 aperture is the discharge and of the internal channel of the
10 prong member. That's the prong member that we've been
11 talking about. It talks about the internal channel and the
12 delivery aperture.

13 Plaintiff's propose that delivery aperture is an
14 opening such as a hole, gap or split for delivery of
15 something. So just plaintiff's definition is going to be
16 consistent with that ordinary meaning.

17 Defendant's definition is the term-- defined the
18 term as delivery aperture as a small opening at the end of
19 the multiple prongs and protruding from the channel. Well,
20 the first point is the word delivery aperture, there's
21 nothing that requires it to be small. Of course, I mean,
22 it's small but small relative to what? Small is a relative
23 term. And there's nothing about small that's mentioned in
24 the patent. So that seems to me that's a term by including
25 small is just going to add confusion. Small compared to

1 what.

2 The second requirement that defendants impose is
3 that the opening must be located at the end of multiple
4 prongs. Well, number one, prongs is not going to be in the
5 ordinary meaning of the terms and certainly it talks about a,
6 a small opening-- singular. So you have a singular opening
7 at the end of multiple prongs is not disclosed anywhere in
8 the patent. There's no embodiment that has a opening-- an
9 opening at the end of multiple prongs. This is a opening.
10 It's singular. Because it's at least one prong member.

11 The third is, the opening must extend from the
12 multiple prongs. The context of the claim, the opening as at
13 the end, and that opening doesn't protrude from anything.
14 The channel may extend it through the prong of course, but
15 the opening is going to be at the end of that channel.

16 Thank you, your Honor.

17 THE COURT: Okay Mr. Burnside.

18 How do you address or why is small there? Why is
19 the end versus the beginning-- where do the multiple prongs
20 come from etc.?

21 MR. BURNSIDE: Okay. Thank you, your Honor.

22 Your Honor, if you look at figure 1a, as an example
23 to illustrate exactly where the delivery aperture relative to
24 the nearby component is, you will see that the delivery
25 aperture which is number 22 is at the end of the prongs. Or

1 if your Honor were to ultimately disagree with us the prong
2 as the case may be. But it is clearly at the end of the
3 prongs from what this patent says. And, moreover, in her
4 deposition testimony Ms. Markell made clear that they are
5 small openings. Now perhaps it should say, smaller opening
6 relative to a channel or the canal, or something like that,
7 which I certainly would be open to. Because we do want to
8 get this correct. And I would further add that I think
9 perhaps through some inartful definition on our part, I think
10 counsel may have misunderstood our proposed construction. It
11 almost seems, again if I'm misstating it it's not
12 intentional.

13 I think what Mr. Norman was saying that the small
14 opening had to be at the end of multiple prongs. Perhaps
15 what it should say is that the small openings at the end of
16 each prong. We're not suggesting it is one opening and that
17 somehow all of the prongs merge into-- that each prong would
18 have an opening.

19 So if you look at figure 1a, the four prongs that
20 were depicted there each one would have the small opening or
21 perhaps better stated. A smaller opening as compared to
22 something else. The tube, the canal, the channel, the
23 applicator head, what have you. So it is a small opening at
24 the end of each prong as further to be defined by your
25 Honor. And that's clearly what is intended by Ms. Markell.

1 And that might even address the question you posed at the end
2 of the discussion about prongs.

3 Unless you have any other questions I don't think I
4 have anything further to add other than what's in our
5 briefing.

6 THE COURT: Okay. Thank you.

7 MR. BURNSIDE: Thank you.

8 MR. NORMAN: Briefly, your Honor.

9 THE COURT: Yes.

10 MR. NORMAN: For the internal channel at the end of
11 multiple prongs, so to say that would mean that that would be
12 an internal channel at the end of the multiple prongs would
13 require that there will be-- or I should say delivery
14 aperture. The claim requires only one internal channel. And
15 the claim requires only one delivery aperture. And if
16 there's only one delivery aperture then there's no way that
17 the delivery aperture could be construed as requiring
18 multiple delivery apertures as Mr. Burnside is currently
19 arguing. There has to be only one internal channel, only one
20 delivery aperture, because the claim requires only one prong
21 member.

22 Thank you, your Honor.

23 THE COURT: Thank you.

24 MR. NORMAN: Your Honor, the next term is flexible
25 deformable material. Now the phrase flexible deformable

1 material occurs twice. One is going to be said chamber of
2 said applicator base being composed of a flexible deformable
3 material. And then said flexible deformable material being
4 composed of rubber etc, etc.

5 So the question is what is the meaning of flexible
6 deformable material. Now, flexible, let's go back to that
7 language. If we look just in the claim itself, we look,
8 okay, these are commonly used words. Flexible deformable and
9 material. Flexible means able to be flexed. That's the very
10 meaning. Deformable means able to be deformed. Well
11 deformable and flexible are the same thing. So it is really
12 a little bit redundant. But flexible deformable material is
13 going to be a material that is capable of being flexed.
14 That's the ordinary meaning of the term.

15 Now, in connection with the term flexible
16 deformable material, the term was not explicitly defined
17 anywhere in the patent or the patent specification. No
18 Lexicography referred to as flexible deformable material so
19 it must be given as a ordinary meaning. And there's no
20 disavowal with respect to flexible deformable material.

21 Plaintiffs propose that flexible deformable
22 material is material that can be flexed. Defendants define
23 the term flexible deformable material as rubber having a
24 thickness of 1/32 of an inch to 3/32's of an inch. The claim
25 is going to require the rubber limitation of course, but

1 rubber having a thickness of 1/32 of an inch to 3/32 of an
2 inch is certainly an ordinary meaning of an ordinary
3 definition of flexible deformable material. The patent was
4 never defined to interpret flexible deformable material in
5 this manner. Neither expert said the term flexible
6 deformable material means rubber having a thickness of 1/32's
7 of an inch to 3/32's of an inch. As a matter of fact talking
8 about, rubber have a thickness of 1/32 to 3/32's of an inch,
9 you're providing really no meaning to flexible deformable
10 material.

11 So for at least these reasons defendants'
12 definition is not the plain and ordinary meaning. And so we
13 would request that the Court adopt plaintiffs' proposed
14 definition and reject defendants' proposed definition.

15 Thank you.

16 THE COURT: Okay. Mr. Burnside or Mr. Slocum?

17 MR. BURNSIDE: Yes, your Honor, Mr. Slocum will
18 handle this.

19 THE COURT: All right.

20 MR. SLOCUM: Thank you, your Honor.

21 Your Honor, the defendants' definition of flexible
22 deformable material goes back to a piece of the story-- let's
23 put it this way, which is an oblique reference to it and no
24 one has focused on it just yet. And that's what actually
25 happened before the USPTO, your Honor.

1 So when the plaintiffs and the patentee first
2 applied for this patent to the USPTO, what's now being said--
3 and this is all set out in our papers, Judge, and it is
4 highlight here. What was now Claim 1 was smaller. It was
5 only subsections A, B and C. That claimed the direct
6 delivery applicator. They claim the prongs. They claimed
7 various other components of the device. But it made
8 absolutely no reference to material composition of any
9 portion of the device. That was all reserved to dependent
10 claims. And effectively the USPTO said absolutely not.

11 It said, looking at the prior art, there are two
12 references in particular that we mentioned in our brief.
13 Looking at the prior art you don't get this patent. In fact,
14 the only way that you get this patent is if you limit the
15 material composition of the chamber of the base to flexible
16 deformable material. And, in fact, the USPTO jumped over
17 flexible deformable material and went straight to rubber.
18 And said because of a function of the way the dependent
19 claims are drafted it had to incorporate dependent claim
20 three. Because the PTO wanted to take defendant claim 4
21 rubber, and rubber is 1/32 of an inch and 3/32's of an inch
22 and said, if you make that material composition part of your
23 patent, part of the independent claims then you get this
24 patent. And the patentee and the plaintiff were happy to
25 accept that limitation at the time in order to be allowed

1 issuance of their patent, your Honor.

2 So by that simple act, by that acceptance of the
3 USPTO's limitation that creates the preclusion and disavowal
4 of any definition of flexible deformable material other than
5 what the claim now reads it to say. It says, the chamber of
6 the basis made up of a flexible deformable material, and that
7 flexible material more specifically is and only is rubber of
8 a thickness of 1/32 of an inch to 3/32's of an inch.

9 And, your Honor, the defendants put to the Court
10 that it is a distinction without a difference to say that the
11 flexible deformable material is not defined as rubber having
12 that particular thickness, but rather is only-- can only be
13 that rubber with that particular thickness, your Honor. And
14 that's what the patent says. The patent says, the chamber of
15 the base is flexible deformable material, which when it comes
16 to this patent the only material that is flexible deformable
17 material is rubber of a particular thickness.

18 Now, there were experts that talked about it,
19 certainly, your Honor, there are many, many other materials
20 that are flexible deformable that are not rubber. But for
21 the terms of this patent flexible deformable material means
22 rubber having a thickness of 1/32 of an inch to 3/32's of an
23 inch.

24 Unless your Honor has any further questions,
25 pending or whatever Mr. Norman may say on rebuttal.

1 THE COURT: Okay. How do you rebut that because you
2 didn't talk about the prosecution history?

3 MR. NORMAN: I think, your Honor-- first of all,
4 Mr. Slocum certainly overstates the prosecution history. The
5 examiner did reject the claims and no attempt was made to
6 persuade the examiner. The claims were amended.

7 Now, a limitation was put in to the claim. That is
8 a claim limitation. That is now in Claim 1. So the fact
9 that-- the fact that the claim requires the rubber having a
10 particular thickness range-- we are certainly not denying
11 that. That is going to be a claim requirement that we will
12 have to prove. The question is though is that in the
13 definition of flexible deformable material.

14 MR. JINKINS: Point out that the rubber is 1/32 and
15 3/32 in the claim.

16 MR. NORMAN: It is in the claim, right. But the
17 fact that rubber is in the claim it will be a requirement
18 that we have to prove exists. We have to prove that the--
19 that every single claim limitation is present in the accused
20 device. But that still is not defining what is flexible
21 deformable material.

22 Now, with respect to-- to the prosecution history
23 though. I would direct the Court's attention to the case of
24 Salazar v Proctor & Gamble, 414 F.3d, 1342, Fed Circuit
25 2005. Mr. Slocum said that because of the prosecution

1 history and what statements the examiner said that that
2 somehow constitutes a disavowal of claim terminology. That
3 is absolutely incorrect.

4 As stated in Salazar v Proctor case, the examiner's
5 statement of reasons for allowance do not limit a claim. And
6 the particular arguments that Mr. Slocum is referencing were
7 found in the examiner's statement of reasons for allowance,
8 but disavowal. What the Court also says in the Salazar is
9 that disavowal must be a statement of the patentee not of the
10 examiner. So that's going to be-- how that happens is in the
11 prosecution history the examiner rejects claims or whatever
12 he does. The examiner issues some type of an office action
13 and sends that to the patent owner's attorney. The patent
14 attorney then will present arguments. The arguments of
15 course of the patent attorney are arguments of the patentee.
16 And a disavowal can occur in the arguments that are going to
17 be made by-- on behalf of the patentee by the patentee's
18 lawyer.

19 And what the Fed Circuit said in the Salazar case
20 is that there's no disavowal based on the statements only of
21 the examiner. It's going to require some action. Some
22 statement by-- by the patentee. And that that statement has
23 to be a clear disavowal. Consistent with the Salazar case,
24 which is going to be consistent with the GE Lighting case,
25 and consistent with the Phillips decision.

1 That's all I have your Honor.

2 THE COURT: All right. Do you want to rebut and
3 what Mr. Norman just said-- don't repeat the argument.

4 MR. SLOCUM: Specifically, your Honor, thank you.

5 With respect to the distinction between statements
6 made by the examiner versus statements made by the
7 applicant. In light of the rejection the applicant patentee
8 did make an amendment and as part of the amendment, again, I
9 believe it's in the papers that I submitted on the ECF docket
10 117, Exhibit C to my declaration. At least in one place
11 where the prosecution history exists. That's page 38.

12 In view of the indication by the examiner that the
13 patent would be disallowed but for this limitation,
14 applicant's amended Claim 1 to require that-- simply, your
15 Honor, in the amendment the applicant did say that in view of
16 the indication by the examiner that being the rejection if
17 not-- that claim 4 was not made independent.

18 The applicant never amended Claim 1 to require that
19 the chamber of the applicator base is composed of flexible
20 deformable material... two. And two, the flexible deformable
21 material is composed of rubber of the specified thickness,
22 your Honor. So there it is not solely by the USPTO.

23 THE COURT: Mr. Norman, this is a yes or no from
24 you on behalf of the plaintiff.

25 Is it disputed that but for the change to specify

1 rubber of a specific thickness this claim would have been, or
2 this patent would not have been issued? In other words, I
3 think the defendant is saying that this is a do or die.
4 Either you put this specification in or you will not get your
5 patent. Is that agreed as factual?

6 MR. NORMAN: No, that's not factual. The answer is
7 no. But the amendment was added so we can't ignore it. The
8 limitation was added to the claim, but we certainly can't say
9 it was required for the application to be allowed. Now we
10 can say that it was made and by making it of course it would
11 be allowed. But that's-- I mean that's a nuance difference
12 perhaps-- but no.

13 THE COURT: Okay.

14 MR. SLOCUM: May I respond very briefly, your
15 Honor?

16 THE COURT: Yes.

17 MR. SLOCUM: Simply, your Honor, the defense
18 doesn't believe that it needs to be conceded by plaintiff at
19 all. The prosecution history speaks for it itself as to what
20 the USPTO said in its rejection of the initial application.
21 Thank you.

22 THE COURT: Okay. Next term.

23 MR. NORMAN: The next term, your Honor, is rubber.
24 Now, the term rubber occurs once and that is going
25 to be-- we already read that and so I guess I wouldn't read

1 it again.

2 MR. BURNSIDE: Your Honor, I don't want to
3 interrupt Mr. Norman. I will step out. There seems to be
4 some confusion about my 3:30 call and so I will step out. I
5 may come back. I will be very quiet when I do.

6 THE COURT: Okay. Thank you. Go ahead.

7 MR. BURNSIDE: Thank you.

8 MR. NORMAN: In the context of the '445 patent, the
9 plain and ordinary meaning of rubber is material natural or
10 synthetic capable of being flexed. The defendants argue
11 rubber means a non rigid, non plastic material, made either
12 from the sap of rubber trees or synthetically to mimic same
13 with a pronounced and intended degree of flexibility.

14 Now the defendants' definition is not the plain and
15 ordinary meaning of flexible deformable. It's not the plain
16 and ordinary meaning of rubber. The specification of the
17 '445 patent does not define rubber or include any indication
18 that the inventor intended to act as her own Lexicographer,
19 and defendants can point to know disavowal with respect to
20 the term flexible deformable material-- sorry, with respect
21 to the term rubber.

22 Defendants incorrectly add-- first, I should say
23 both parties, your Honor, acknowledge that rubber can be a
24 material that is natural or synthetic.

25 THE COURT: Right.

1 MR. NORMAN: Both parties also acknowledge that
2 rubber is a material being flexed. Defendants however had
3 four additional limitations to the definition of rubber that
4 are not part of the plain ordinary meaning. The first one is
5 non rigid. The second is non plastic. The third mimic. And
6 the fourth intended degree of flexibility.

7 Now with respect to non rigid. I guess I would
8 acknowledge that a rubber is going to be non rigid. But both
9 parties have already acknowledged that rubber has to be
10 flexible. And now stating it in the positive makes more
11 sense than stating it in the negative.

12 Now we've already-- both parties' definitions
13 already include a requirement of flexible. So I'm not sure
14 what adding non rigid to the definition would do other than
15 confuse the jury. What does it mean to be both flexible and
16 non rigid. As to non plastic. Non plastic is incorrect
17 because all rubbers are plastics. Defendants' expert said, I
18 mean defendants non plastic limitation is actually
19 contradicted by defendants own expert.

20 Now defendants' expert Mr. Driscoll is an expert in
21 polymers. And he actually wrote a chapter of a book. And in
22 that chapter in his book he said that polymers, resins and
23 plastics are synonymous. And so in deposition he was asked
24 about that. And referencing to his book it says, in the last
25 sentence of third paragraph, which is the last paragraph

1 under basic concepts. It says, however, the terms polymers,
2 resins and plastics are synonymous. Do you see that?

3 Answer: Yes, sir.

4 Question: Do you agree with that?

5 Answer: Yes, sir.

6 Question: Is rubber a polymer?

7 Answer: Yes, sir.

8 So if we look at this, Mr. Driscoll specifically
9 says that rubber is a polymer and that polymers and plastics
10 are synonyms. So if-- if all rubbers are polymers and
11 polymers and plastics are the same thing that means logically
12 all rubbers are plastics. As such, the non plastic
13 requirements in defendants' proposed definition is
14 necessarily incorrect.

15 There are some other statements concerning rubber
16 that Mr. Driscoll testified about. Mr. Driscoll, and we have
17 this cited in our-- we have this cited in our brief as well.
18 These are going to be on pages, well, I mean I'll just direct
19 the Court to that. But what Mr. Driscoll said is, his
20 testimony was that these terms, that the term rubber is a
21 broad term. He said it is an ambiguous term. It's a, you
22 know, a broad term and it's not limiting. He doesn't know
23 what kind of a material that specifies. In other words, what
24 he is saying is, although we may talk in terms of ambiguous,
25 what he really means by that is that the term rubber is a

1 fairly encompassing material. I mean, a fairly encompassing
2 definition.

3 So it will encompass polymers that are capable of
4 flexing and actually are made-- it is going to be elastic
5 type of a material. I mean a flexible plastic would be one
6 that's going to be-- it springs back to its original shape.
7 It is going to have that elasticity. As opposed to saying a
8 plastic bag that, you know, you bunch it up and it doesn't
9 spring back to its shape. Or to a rigid plastic that is not
10 going to deform.

11 As far as the particular rigidity that's being
12 referenced here. To the extent anybody tries to make the
13 argument that flexibility-- everything is flexible to some
14 extent. Well, the patent claim specifies the type of
15 flexibility that's going to be required. Because the claim--
16 can we pull up the claim. So in Section D it says that,
17 chamber of said applicator base being composed of a flexible
18 deformable material so that said chamber can be squeezed to
19 apply enhanced pressure on said solution compartment of said
20 cartridge to facilitate release of said solution from said
21 cartridge and through said prongs. So, I mean, this is
22 talking about somebody using this with their hand, and a user
23 is going to squeeze this compartment and not an infinitesimal
24 amount, but sufficiently squeezing it so that it's going to
25 increase the pressure within the chamber, which will cause

1 the medicine that's in the cartridge to squeeze out of that,
2 and then pass through the channel of the prong member.

3 So we are certainly not saying, nor would a clear
4 reading of the claim make it indefinite as to what is meant
5 by, you know, when we say rubber has to be flexible to what
6 extent. Because the claim provides enough guidance to the
7 reader to understand that.

8 THE COURT: We'll take a ten minute recess.

9 (RECESS TAKEN).

10 THE COURT: Back on the record. I believe there is
11 a couple more issues; but you want a rebuttal or the response
12 on the rubber?

13 MR. SLOCUM: Yes, your Honor. Thank you.

14 Your Honor, if I may begin with respect to rubber.
15 There are two points that the defendants would like to make
16 specific to plaintiffs' proposed definition which is
17 materials natural and/or synthetic capable of being flexed.

18 I will remind the Court of plaintiffs' definition,
19 proposed definition as to flexible deformable material, which
20 is materials that can be flexed.

21 And essentially, your Honor, those two proposed
22 definitions are identical. Flexible deformable material is
23 materials that can be flexed. And rubber, which the patent
24 says is a specification, a subset of flexible deformable
25 material, if rubber is also any material that can be flexed.

1 The inclusion of rubber adds nothing and it would be
2 surplusage. And for that reasonably alone, plaintiffs'
3 proposed definition of rubber should be rejected by the
4 Court.

5 Second, your Honor, it is clearly, one would say
6 facially is over broad. One does not need to be a polymer
7 scientist to know that there are materials capable of being
8 flexed that are not rubber. But fortunately in this case,
9 your Honor, we have polymer scientists who have told us that
10 in the definition, including plaintiffs' expert and Dr.
11 Iezzi's deposition was provided to your Honor. I believe his
12 declaration as well acknowledges that many materials can be
13 flexed, not all of them are rubber. There's wood. Types of
14 metal that could be flexed. Indeed any material of certain
15 potentially -- any material of certain thickness or other
16 physical attributes can be flexed.

17 Your Honor, so for that reason alone, the
18 plaintiffs' definition of rubber is simply unworkable.

19 With respect to defendants' proposed definitions.
20 And again, your Honor, much of what I'm saying is not new,
21 it's in our brief and I won't belabor the point.

22 The four limitations that plaintiffs spent a lot of
23 time refuting were two non ridged and non plastic. You know,
24 defendants don't make that out of air. We get those from the
25 patent itself and from the prosecution history. And also

1 from the plain ordinary meaning of the term rubber.
2 Specifically, with respect to rigidity, your Honor. The
3 column 5 of the patent, this is all part of the preferred
4 embodiment that we were talking about.

5 The invention at line 50 says, chamber of
6 applicator base may be composed of a ridged material, or
7 alternatively, may be composed of a flexible deformable
8 material.

9 Now, that that option for ridged material was
10 before the USPTO rejected the application and made them
11 incorporate the dependent claim of flexible deformable
12 material into the independent claim. But that distinction
13 that the patent itself draws between ridged materials and
14 flexible deformable materials, rubber as we know the patent
15 tells us is a subset or an extension of a flexible deformable
16 material-- therefore it's not ridged. Because the patent
17 says if you have ridged materials, you also have flexible
18 deformable materials. They are alternative to each other.

19 Further, your Honor, within the prosecution
20 history, when the USPTO was distinguishing the prior art and
21 saying the reason why we'll not allow claim 4 as an
22 independent claim is because it is different to the two prior
23 references. One, the Dovergne, D-O-V-E-R-G-N-E, that
24 reference does not disclose or suggest rubber, only plastic,
25 your Honor. And so USPTO has drawn a very distinct line of

1 demarkation between rubber and plastic.

2 THE COURT: Let me stop you for just a minute.

3 Thank you.

4 (PAUSE).

5 THE COURT: Okay. Back on the record. Continue.

6 Thank you.

7 MR. SLOCUM: Thank you, your Honor. So the USPTO
8 also drew the line between rubber as a term that is used in
9 the patent and a ridged plastic.

10 As I stated, your Honor, the Dovergne reference,
11 the USPTO says at docket number 117, page 45, that Dovergne
12 does not disclose or suggest rubber as a flexible deformable
13 material only plastic. Again, drawing a line between rubber
14 and plastic.

15 And further, the USPTO says Robinson, the other
16 piece of prior art, actually teaches away from rubber by
17 disclosing a ridged plastic. If the rubber -- however, the
18 Court decides to define rubber in this patent.

19 And another point I am not sure any party has
20 noted, your Honor. The Court is not bound to select A or B.
21 The Court could fashion its own definition composite of the
22 two or reject both. But, however the Court defines rubber,
23 the defendants put it that if it does not include a non
24 ridged, non plastic component then the '445 patent never
25 would have issued. Because that's what the USPTO required.

1 Finally, your Honor, looking at the expert
2 testimony. Both sides agree, your Honor, as Mr. Norman said
3 early on no one is arguing any term in this dispute as a term
4 of art. And for those reasons, the expert testimony does
5 actually very little help to the Court. And with respect to
6 the deposition citation to defendants' expert, Mr. Driscoll,
7 plaintiffs' slide 49 ended the quotation at line 1076.

8 Further, on the same page, your Honor, the question
9 put to Mr. Driscoll: Would that mean that that rubber and
10 resins and plastics are synonymous in some areas of the
11 industry?

12 Answer: No, sir.

13 Question: Why not?

14 Onto page 108.

15 Because rubber is still an ill defined term.

16 What does ill defined mean?

17 It's ambiguous, your Honor.

18 So simply stated, your Honor. That's at docket
19 119-5, page 5 of 8 from the defendants' responsive papers.
20 That excerpt from the deposition-- it's not clear. I think
21 it's inaccurate to say that defense expert agreed that all
22 plastics are rubber, all rubbers are plastic. Like your
23 Honor said not all bugs are insects. Some insects aren't
24 bugs. This factor is no more starkly put on display than
25 plaintiffs' expert deposition where when shown an object,

1 which I brought your Honor is D-56, which is a Bic pen, under
2 plaintiffs' definition this object is rubber.

3 In closing, your Honor, simply the common ordinary
4 understanding of rubber does not include a Bic pen.

5 Thank you.

6 THE COURT: Thank you. Moving on from rubber, move
7 on from rubber. Rubber.

8 MR. NORMAN: Our primary term, the last term, the
9 defendants didn't even propose a definition.

10 May I make a brief comment about rubber?

11 THE COURT: Very brief.

12 MR. NORMAN: Counsel talked about -- first of all,
13 as we said in our brief all rubbers are polymers. All
14 rubbers are plastics. We did not say that rubber and plastic
15 are synonymous. We never said that all plastics are
16 rubbers. So we did ask Mr. Driscoll are all rubbers
17 plastics? I should say are rubbers and plastics synonymous?
18 He wasn't willing to say that. And we're not disagreeing
19 with that conclusion. As a matter of fact, as I said
20 earlier, rubbers are elastic polymers as opposed to ridged
21 polymers or ridged plastics.

22 If we look at the prosecution history, the same
23 section that Mr. Slocum was talking about, what we really see
24 is that the examiner was distinguishing rubbers not from
25 plastics, but rubber from ridged plastic.

1 With respect to the Dovergne reference. The
2 examiner was saying that all that is disclosed by Dovergne
3 was plastic. It didn't specify the type of plastic. And for
4 an examiner to reject the claim, the examiner would have to
5 establish that there was a rubber that was going to be
6 disclosed in that prior art reference.

7 The examiner said that Dovergne does not disclose
8 or suggest rubber as a flexible deformable material only
9 plastics. So it disclosed only plastics. The Dovergne
10 reference didn't disclose a flexible plastic. So it didn't
11 disclose rubber.

12 With respect to Robinson. The examiner said,
13 Robinson discloses a thickness measurement, but it does not
14 disclose rubber as a material, and actually teaches away from
15 rubber by disclosing a ridged plastic handle.

16 The examiner is not saying that plastic is
17 something different from rubber. And even if the examiner
18 did, which he didn't, but additionally, the examiner cannot
19 change the meaning of a term. Can't do it.

20 And that I will direct the Court again to the
21 Salazar v Proctor and Gamble case, 414 F.3d, 1342. That
22 examiner's statement for the reasons for allowance do not
23 limit a claim. And the Salazar case also says that an
24 examiner can't change the meaning of the words.

25 So there was no disavowal in connection with the

1 term rubber. Defendants -- I mean, the patentee did not
2 change the meaning of the term rubber in any respect. And
3 rubber, we're not saying rubber is synonymous with polymers.
4 We are certainly not saying rubber is any flexible material.
5 But rather is -- rubber is going to be an elastic polymer.
6 Or an elastic, you know, which is also going to be consistent
7 with what we have presented in our arguments.

8 So if the Court wants to modify our definition by
9 including the term flexible polymer, or even elastic polymers
10 along with the flexible deformable material so it may be a
11 polymeric, something like -- none of these words are
12 magical. But an elastic polymer, natural or synthetic,
13 capable of being flexed. So if the Court wants to add
14 elastic polymer we would certainly be comfortable with that.

15 MR. NORMAN: Thank you.

16 THE COURT: Thank you. And polymer material.

17 MR. NORMAN: Yes. And then the term polymer. As I
18 indicated earlier polymer is going to be synonymous with
19 plastic. So the ordinary meaning of polymeric is of or
20 related to a polymer. Defendants provide no definition of
21 the term, arguing that the term is indefinite. But the term
22 is a broad term. There's no question polymeric, just like
23 plastic would be a broad term, but being broad does not make
24 a term indefinite. It just makes the term broad. Polymeric
25 material is simply a material that is a polymer or contains a

1 polymer.

2 The defendants assert that Mr. Driscoll is an
3 expert skilled in the art of polymers. And I will note for
4 the record that defendants have not proposed any definition
5 for the term polymeric material. They say it's incapable of
6 being defined. I will note that Mr. Driscoll is an expert
7 skilled in the art of polymers.

8 Now Mr. Driscoll stated in his declaration that
9 polymeric material would generally refer to any material that
10 is a polymer and includes wide families of products such as
11 adhesives, coatings, composites, elastomers, fibers, glues,
12 plastics and reenforced plastics. All of these are
13 classified as polymers.

14 All right. So this is what Mr. Driscoll stated in
15 his declaration. Mr. Driscoll was obviously able to define
16 polymeric material. But then in his deposition he was just
17 arguing, well, it's a broad term and therefore I don't know
18 what specific material is being required by the claim. But
19 no particular polymeric material -- the claim requires that
20 the polymeric material would be a light weight polymeric
21 material.

22 But in any event, the claim doesn't specify any
23 type of -- what the specific type of polymeric material is,
24 but that just makes the claim limitation broad. It doesn't
25 make it indefinite.

1 The fact that Mr. Driscoll knows what a polymeric
2 material is, the assertion by the defendants that the term
3 polymeric is indefinite, lacks creditability. And as far as
4 some of these other things that polymeric material can mean
5 liquids and all of that type of stuff. Well, no, it really
6 can't. Because in the context of the claim, the claim says
7 that the direct delivery applicator comprises of a light
8 weight polymeric material. It can't be liquid.

9 Even though it can be a polymeric material, we
10 already know that there are going to be limitations in Claim
11 1. Claim 16 requires all of the limitations of Claim 1. And
12 all of these limitations that are in Claim 1 we are certainly
13 going to have to prove.

14 I cannot envision a scenario where a product could
15 be encompassed by Claim 1 and Claim 16 with the polymeric
16 material being a liquid. Nevertheless, the definition of
17 polymeric material itself is a broad term.

18 Thank you, your Honor.

19 THE COURT: Thank you.

20 MR. SLOCUM: Thank you, your Honor. Your Honor,
21 very briefly on polymeric material.

22 As Mr. Norman stated all of the claims, Claim 16
23 requires that all the limitations of Claim 1 also be proven
24 and applied for Claim 16 to apply. Simply stated, your
25 Honor, if the defendants are correct and that rubber is a

1 particular subset of polymers distinct from plastic and that
2 the chamber of the base has to be rubber as we read Claim 1,
3 then Claim 16 in effect would expand Claim 1, wherein the
4 entire applicator in Claim 16 reading, a direct delivery
5 applicator as recited by Claim 1, being composed of a light
6 weight polymeric material. That would mean all components of
7 the applicator are composed of any polymeric material. Not
8 rubber.

9 So, your Honor, if defendants are correct and that
10 the applicator base has to be rubber and rubber is different
11 from plastic and rubber is only one of a number of many types
12 of polymers then 16 is contradictory and expand Claim 1, and
13 it makes no sense and therefore it can't mean what it would
14 seem to mean, which would mean any polymeric material.
15 Legally and specific speaking and that's why we argue it is
16 indefinite.

17 The second point, your Honor, is one of the
18 definitions for indefinite as set forth in the case Nautilus
19 Incorporated case (ph) by the Supreme Court, is that read in
20 light of the specification and the prosecution history it
21 fails to inform with reasonable certainty the scope of the
22 invention. That's what Mr. Driscoll said in his declaration
23 and deposition. Just looking at it, he didn't know what they
24 were referring to.

25 So unless your Honor has any specific questions,

1 the defense has nothing further.

2 THE COURT: I've got it.

3 MR. NORMAN: Your Honor, one minor comment. And
4 that only indefiniteness is not an issue to be addressed
5 now. Indefiniteness is going to be something that defendants
6 are going to bear the burden of proof by clear and convincing
7 evidence. The defendants can make whatever argument they
8 want about indefiniteness after the claim construes the
9 claim, but just as the Court is not supposed to consider
10 issues of-- consider the infringement issues at this point--
11 neither is it supposed to consider the validity issues.
12 Thank you.

13 THE COURT: Okay. Thank you. Counsel, I don't
14 think there are any other issues that oral argument need
15 address. Part of what I wanted to get accomplished today I
16 certainly did. That was to have an opportunity to ask
17 questions and to kind of listen to the arguments that are
18 made on the papers. I can't stress enough, I wish we had to
19 do more oral argument. Even if all you did was to
20 robotically recite your arguments, which you didn't do, you
21 gave them life and spunk, it's just important, especially in
22 a technical area like this and where it could be overlooked
23 by just reading briefs what the essential differences are
24 between and among your positions.

25 So I thank you very much for that. I intend to

1 issue a written decision. And we're going to try to get it
2 out within the next -- I would say four to five weeks no more
3 than that. I will keep to my schedule and you will keep to
4 yours.

5 Thank you very much. Safe travel to those who came
6 from far away.

7 MR. NORMAN: Thank you.

8 MR. SLOCUM: Thank you, your Honor.

9 THE COURT: Thank you.

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